Syarikat Zamani Hj Tamin Sdn Bhd & Anor v Yong Sze Fun & Anor

HIGH COURT (KUALA LUMPUR) — CIVIL NO D5–22–4760 OF 1998
RAMLY ALI J
17 APRIL 2006

Trade Mark — Passing off — Elements of — Brand well known to customers in market — Whether ingredients of goodwill, misrepresentation and damage present — Whether plaintiffs have acquired goodwill in trade mark — Whether there was confusion and deception in the market — Whether plaintiff had suffered or likely to suffer damage or injury to its business or goodwill — Whether there was passing off

Trade Mark — Passing off — Elements of — Related fields of activity — Likelihood of confusion

Trade Mark — Passing off — Goodwill — Application for injunction — Whether there was unreasonable delay — Laches

Tort — Libel and slander — Complaint of passing off to Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs — Whether elements established

The first plaintiff is a manufacturer and distributor of foodstuff, which include amongst others, sauces, vermicelli and syrups. The second plaintiff is a manufacturer and distributor of foodstuff and is an associate company of the first plaintiff. Both the first and second defendants are individuals manufacturing and/or carry on trading and are merchants of base syrups, flavourings and cordials of various flavours. The first and second plaintiffs carry on their business by manufacturing, selling and distributing their products by the trade mark 'TAMIN'. The defendants in the course of their trade and business have been manufacturing and/or have manufactured for sale, distributing and selling their cordials, flavourings and syrups bearing the word 'TAMIN' identical and/or confusingly and colourably similar to the plaintiffs' trade mark. By virtue of the identical nature of the marks and by reason of the fact that the goods of interest to which the respective 'TAMIN' marks were employed in relation to are the same or of the same description, the plaintiffs prayed for, inter alia, an injunction to restrain the defendants from passing off or attempting to pass of syrups and other goods of a similar description by the manufacture, supply, distribution sales and offer for sales of the same with the trade mark 'TAMIN' or any other trade mark which is deceptively and confusingly similar thereto and unlawfully appropriating the plaintiffs' goodwill, reputation and commercial advantage in the field of trade and business relating to sauces and other products of a similar description or assisting any

A others to do so by the manufacture supply, distribution sales and offer for sales of the same the trade mark 'TAMIN' or any other trade mark which is deceptively and confusingly similar thereto. The defendants counter claimed against the plaintiff on the basis that the plaintiffs by using 'TAMIN' in relation to cordials, syrups and flavourings had passed off their products as and for the products of the defendants
B and that the plaintiffs had committed slander to title and to the goods of the defendants by lodging complaints with the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs resulting in the Enforcement Division raiding the defendants' premises and seizing the defendants products bearing the 'TAMIN' trade mark.

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Held:

(1) The plaintiffs and/or their predecessors in title had used the 'TAMIN' trade mark for a significant period of time. The evidence showed that 'TAMIN' was
D first used in 1951. Since 1951, there has been considerable extension and expansion of goods by the plaintiffs and their predecessors of the 'TAMIN' trade mark. The plaintiffs which took over the businesses extended the use of 'TAMIN' to cover a wide range of food and drink products (see para 84). The evidence that the plaintiffs have taken over the businesses of their
E predecessors in title thereby according them all goodwill associated therewith was evident from the memorandum and articles of association of the plaintiffs. As the 'TAMIN' trade mark had been consistently and continuously used in conjunction with the businesses of the plaintiffs, it was the badge and the indicator of the goodwill in the businesses run by the plaintiffs and their
F predecessors in title. The 'TAMIN' trade mark was clearly distinctive of the plaintiffs (see para 86).

(2) Goodwill and reputation with reference to a trade mark can further be jointly and severally held as was the case here where the plaintiffs derived title from their predecessors. Both plaintiffs were entitled to use the 'TAMIN' trade mark
G and both had established goodwill and reputation in their business with reference to the 'TAMIN' trade mark. The plaintiffs therefore have the relevant and necessary locus standi to commence this action (see para 88).

(3) The plaintiffs' cause of action was one of passing off. Therefore, the trade mark registrations for 'TAMIN' have little or no relevance to the facts in dispute.
H Given the fact that the Trade Marks Act 1976 expressly preserves the cause of action in passing off, the plaintiffs' rights to 'TAMIN' as a badge and indicator of their business goodwill was preserved (see para 95).

(4) Any alleged licensing arrangements vis-a-vis the common law rights to the mark are arrangements between the parties. It was not for the defendants to
I interfere with or use it as a means of escaping liability. The matter should be considered in the context of whether the defendants have indulged in acts that could result in damage to the business and goodwill of the plaintiffs. The defendants have no connection with the goods of the plaintiffs and were thus in no position whatsoever to complain. The defendants cannot rely on a technicality to defeat the claim of the plaintiffs (see para 106).

(5) The plaintiffs and/or the predecessors were the first users of the 'TAMIN' trade mark in relation to a whole range of products. The defendants only commenced use of the 'TAMIN' trade mark well after the use by the plaintiffs. The evidence showed that the trade and public confused the defendants' TAMIN' as and for the plaintiffs' 'TAMIN' (see para 141).

(6) There was no necessity to prove actual damage. If the parties are in a common field of activity, damage would be presumed and inferred by the court. There was without doubt that the activities of the defendants and the plaintiffs were the same and both are in the business of manufacturing, supplying and selling items of drink. The plaintiffs' business further extended to the manufacture, supply and sale of various food items as well and food and drink items being goods of the same description were sold through the same channels and often compete with each other (see para 148).

(7) The acts of the defendants would result in damage to the goodwill and reputation of the plaintiffs. The plaintiffs would lose exclusivity over their well established and developed trade mark. If the defendant's products did not meet up to the standards associated with the plaintiffs' products, such lack of quality would be attributed to them resulting in loss to the goodwill and reputation (see para 151).

(8) Despite the defendants' assertion that the 'TAMIN' trade mark was an important trade mark to them, the defendants did not take the matter up further. Therefore, it would be the defendants and not the plaintiffs who would be guilty of laches. The evidence has shown that subsequent to the plaintiffs' response that they were the legitimate proprietors of the trade mark; it was the plaintiffs who took further action against the defendants when they discovered the continued presence of the defendants' goods in the market (see para 156).

(9) Since the plaintiff's rights to the 'TAMIN' trade mark clearly stand in priority over the rights of the defendants, the defendants counter claim against the plaintiffs for passing off should fail (see para 171). There was no sustainable reason in fact or in law to uphold the defendants' counter claim in passing off (see para 173).

(10) The statements made to the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs were true. The claims of the plaintiffs' in passing off were clearly made out. Therefore the claim by the defendants of slander must fail. There was no issue of disparagement. Denigration did not arise and the plaintiffs were well within their rights to complain to protect and preserve their rights. The complaint of the plaintiff was independently evaluated by the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs and was held to be well founded and legitimately made (see para 180).

[Bahasa Malaysia summary

Plaintif pertama adalah pengilang dan pengedar makanan yang mana antara lain termasuk sos, vermiseli dan sirap. Plaintif kedua adalah pengilang dan pengedar makanan dan merupakan syarikat sekutu plaintif pertama. Kedua-dua defendan

pertama dan kedua adalah individu-individu pengilang dan/atau adalah pedagang dan saudagar bagi bahan-bahan seperti sirap, perisa dan kordial bagi pelbagai perisa. Plaintif pertama dan kedua telah meneruskan perniagaan perkilangan, penjualan dan pengagihan produk-produk melalui tanda niaga 'TAMIN'. Defendan-defendan dalam perjalanan perniagaan mereka telah mengilang dan/atau telah mengilang jualan, mengagihkan dan menjual kordial, perisa dan sirap, di mana perkataan 'TAMIN' adalah serupa dan/atau mengelirukan dan sama dengan tanda niaga plaintif. Melalui sifat keserupaan tanda niaga dan disebabkan oleh kepentingan barangan di mana tanda niaga 'TAMIN' telah digunakan berkenaan adalah sama atau sama deskripsi, plaintif—plaintif telah memohon, antara lain, satu injunksi untuk menyekat defendan-defendan daripada kelirupaan atau percubaan kelirupaan sirap dan bahan-bahan lain yang mana deskripsinya adalah sama oleh pengilang, pembekalan, pengagihan jualan dan tawaran jualan yang sama dengan tanda niaga 'TAMIN' atau tanda niaga lain yang mengabui dan sama mengelirukan dan nama baik, reputasi dan kelebihan komersil di dalam perdagangan dan perniagaan berkenaan sos dan produk-produk lain yang mana deskripsinya adalah sama atau menolong yang lain berbuat demikian melalui perkilangan permintaan, pengagihan jualan dan tawaran jualan yang sama tanda niaga 'TAMIN' atau tanda niaga lain yang mana adalah mengabui dan mengelirukan. Defendan-defendan menuntut balas terhadap plaintif berdasarkan kepada penggunaan 'TAMIN' berkaitan kordial, sirap dan perisa telah melepaskan produk-produk mereka sebagai produk-produk defendan dan plaintif-plaintif telah komit kepada kenyataan lisan yang tidak benar dan barangan defendan dengan melaporkan aduan dengan Penguatkuasa bahagian Kementerian Perdagangan dan Hal Ehwal Pengguna dengan penguatkuasa bahagian membuat serbuan ke atas premis defendan dan merampas produk-produk defendan dengan penggunaan tanda niaga 'TAMIN'.

Diputuskan:

(1) Plaintif-plaintif dan/atau pendulu dalam hak milik telah menggunakan tanda niaga 'TAMIN' bagi satu jangka masa yang ketara. Keterangan menunjukkan bahawa 'TAMIN' mula-mula digunakan dalam tahun 1951. Sejak 1951, wujud pelanjutan dan peluasan yang munasabah bagi barangan oleh plaintif dan pendulu terdahulu tanda niaga 'TAMIN'. Plaintif yang telah mengambil alih perniagaan telah memanjangkan penggunaan 'TAMIN' untuk merangkumi makanan dan produk minuman. Keterangan bahawa plaintif-plaintif telah mengambil alih perniagaan pendulu dalam hak milik, yang mana menurut mereka kesemua nama baik yang tersangkut kepadanya adalah daripada memorandum dan perkara-perkara persatuan plaintif. Di mana tanda niaga 'TAMIN' telah digunakan berterusan dengan perniagaan plaintif-plaintiff, ia merupakan satu tanda nama baik perniagaan yang dilaksanakan oleh plaintif dan pendulu dalam hak milik. Tanda niaga 'TAMIN' adalah jelas menampilkan plaintif (lihat perenggan 86).

(2) Nama baik dan reputasi dengan rujukan kepada tanda niaga boleh bersesama dan berasingan diputuskan sebagai kes di sini di mana plaintif telah memperolehi hak milik mereka daripada pendulu-pendulu. Kedua-dua plaintif berhak menggunakan tanda niaga 'TAMIN' dan kedua-duanya telah mewujudkan nama baik dan reputasi perniagaan mereka dengan rujukan

kepada tanda niaga 'TAMIN'. Plaintif-plaintif, oleh itu mempunyai lokus standi yang relevan untuk memulakan tindakan ini (lihat perenggan 88). A

(3) Kausa tindakan plaintif adalah satu kelirupaan. Oleh itu, pendaftaran bagi tanda niaga 'TAMIN' mempunyai sedikit atau tiada relevan kepada pertikaian fakta-fakta. Memandangkan Akta Cap Dagangan 1976 dengan nyata memelihara/mengekalkan kausa tindakan dalam kelirupaan, hak-hak plaintif kepada 'TAMIN' sebagai lambang dan nama baik perniagaan telah dipelihara (lihat perenggan 95). B

(4) Sebarang pengataan penyusunan lesen berbanding dengan hak-hak 'common law' kepada tanda merupakan penyusunan antara parti-parti. Adalah bukan untuk defendan campur tangan atau menggunakannya sebagai cara untuk melepaskan diri daripada liabiliti. Perkara tersebut patut dipertimbangkan di dalam konteks sama ada defendan-defendan sudah melibatkan diri dalam aktiviti-aktiviti yang mungkin membawa kepada kerosakan perniagaan dan nama baik plaintif-plaintif. Defendan-defendan tiada kaitan dengan barangan plaintif-plaintif dan bukan dalam kedudukan untuk membuat aduan. Defendan-defendan tidak boleh bergantung kepada keteknikan untuk mengalahkan tuntutan plaintif-plaintif (lihat perenggan 106). C D

(5) Plaintif-plaintif dan/atau pendulu-pendulu adalah pengguna-pengguna pertama tanda niaga 'TAMIN' berkenaan dengan kesemua produk-produk. Defendan-defendan hanya mula menggunakan tanda niaga 'TAMIN' selepas penggunaannya oleh plaintif-plaintif. Keterangan menunjukkan bahawa perdagangan dan awam telah mengelirukan defendan-defendan 'TAMIN' seperti dan untuk plaintif 'TAMIN' (lihat perenggan 141). E

(6) Tidak ada keperluan untuk membuktikan kerosakan sebenar. Jikalau parti-parti adalah dalam satu bidang aktiviti yang sama, kerosakan boleh dianggap dan mahkamah boleh membuat inferens. Tanpa keraguan, aktiviti-aktiviti defendan dan plaintif-plaintif adalah sama dan kedua-dua adalah dalam perniagaan perkilangan, pembekalan dan penjualan minuman. Perniagaan plaintif telah dilanjutkan kepada perkilangan, pembekalan dan jualan pelbagai makanan dan minuman, di mana merupakan barangan dengan deskripsi sama telah dijual melalui saluran sama dan senantiasa bertanding sesama lain (lihat perenggan 148). F G

(7) Tindakan-tindakan defendan boleh menyebabkan kerosakan terhadap nama baik dan reputasi plaintif-plaintif. Plaintif-plaintif boleh hilang eksklusif mereka terhadap perkembangan tanda niaga. Jikalau produk-produk defendan tidak mencapai standard berhubung dengan produk-produk plaintif, kekurangan kualiti boleh dikaitkan kepada mereka menyebabkan kerosakan nama baik dan reputasi (lihat perenggan 151). H

(8) Melainkan penegasan defendan bahawa tanda niaga 'TAMIN' adalah tanda niaga yang penting kepada mereka, defendan-defendan tidak mengambil perkara tersebut selanjutnya. Oleh itu, adalah defendan dan bukannya plaintif-plaintif yang bersalah terhadap tuduhan 'laches'. Keterangan menunjukkan bahawa berikutan jawapan plaintif bahawa mereka adalah tuan I

punya tanda niaga yang sah, plaintif-plaintif yang telah mengambil tindakan selanjutnya terhadap penerusan kehadiran barangan defendan di dalam pasar (lihat perenggan 156).

(9) Memandangkan hak-hak plaintif terhadap tanda niaga 'TAMIN' adalah jelasnya memberi keutamaan ke atas hak-hak defendan, defendan-defendan menuntut balas terhadap plaintif-plaintif bagi kelirupaan patut gagal (lihat perenggan 171). Tidak ada sebab yang munasabah untuk mengekalkan fakta-fakta atau dalam undang-undang bagi mengesahkan tuntutan balas defendan dalam kelirupaan (lihat perenggan 173).

(10) Penyataan-penyataan yang dibuat kepada Bahagian Penguatkuasaan Kementerian Perdagangan Dalam Negeri dan Hal Ehwal Pengguna adalah benar. Tuntutan plaintif dalam kelirupaan adalah dengan jelas. Oleh itu, tuntutan defendan berkenaan kenyataan secara lisan yang tidak benar mesti gagal. Tidak ada isu yang meremehkan. Sikap memburuk-burukkan tidak timbul dan plaintif mempunyai hak untuk mengadu untuk melindungi dan memelihara hak-hak mereka. Aduan plaintif dinilai berasingan oleh Bahagian Penguatkuasaan Kementerian Dalam Negeri (Perdagangan dan Hal Ehwal Pengguna) dan diputuskan mempunyai asas dan telah sah dikemukakan (lihat perenggan 180).]

Notes

For cases on elements of trade mark, see 12 *Mallal's Digest* (4th Ed, 2002 Reissue) paras 1809–1817.

For cases on goodwill, see 12 *Mallal's Digest* (4th Ed, 2002 Reissue) paras 1819–1821.

For cases on libel and slander, see 12 *Mallal's Digest* (4th Ed, 2002 Reissue) paras 485–501.

Cases referred to

AG Spalding & Bros v AW Gamage [1915] 32 RPC 273 (refd)
Annabel's v Schock [1972] RPC 838 (refd)
Besalon International Limited & 2 Ors v South Strong Industries Sdn Bhd [1997] 2 AMR 1333 (refd)
British Railway Traffic v CRC Co [1922] 2 KB 260 (refd)
Bulmer (HP) Ltd v Bolinger SA [1978] RPC 79 (refd)
Burberry's v JC Cording & Co Ltd [1909] 26 RPC 693 (refd)
Chelsea Man Menswear Ltd v Chelsea Girl Ltd [1987] RPC 189 (refd)
Dent v Turpin [1996] ER 1003 (refd)
DHN Food Distributors Ltd v Tower Hamlest Londin Borough Council [1976] 1 WLR 852 (refd)
Eastman Photographic Materials Co v John Griffiths [1898] 15 RPC 105 (refd)
Electro Cad Australia Pty Ltd v Mejati RCS Sdn Bhd [1988] 3 MLJ 422 (refd)
Erven Warnick v Townsend & Sons [1979] AC 731 (refd)
Greers Ltd v Pearman and Corder Ltd [1922] 39 RPC 406 (refd)
H & R Johnson Tiles Ltd & Anor v H & R Johnson (M) Bhd [1998] 4 MLJ 13 (refd)
Habib Bank Ltd v Habib Bank AG Zurich [1981] 1 WLR 1265 (refd)
Haw Par Brothers International Ltd v Jack Chiarapurk [1991] 2 MLJ 428 (refd)
Irvine v Talksport [2002] 60 FSR 943 (refd)

JS Staedler & Anor v Lee & Sons Enterprise Sdn Bhd [1993] AIPR 365 (refd)
Kaye Robertson [1991] FSR 62 (refd)
Lam Soon (M) Bhd v Forward Supreme Sdn Bhd & Ors [2001] 6 MLJ 651 (refd)
Lego System A/s v Lego M Lemelstrich Ltd [1983] FSR 155 (refd)
Midgley v Morris & Cowdery [1904] 21 RPC 314 (refd)
Pakai Industries Bhd v Chen Yew Industries Sdn Bhd [1991] 2 CLJ 1574 (refd)
Perry v Truefitt (1842) 6 Beav 66 (refd)
Rechitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 AII ER 873 (refd)
Revon v Cripps [1980] FSR 85 (refd)
Service Master (M) Sdn Bhd v MHL Service Master Sdn Bhd & Anor [1998] 1 CLJ 459 (refd)
Star Industrial Co Ltd v Yap Kwee Kor [1976] 2 FSR 256 (refd)
The Commissioners of Inland Revenue v Muller & Co's Mergarine Ltd [1901] AC 217 (refd)
Tong Guan Food Products Pte Ltd v Hoe Huat Hing Foodstuff Pte [1991] 2 MLJ 361 (refd)
UBE Engineering Sdn Bhd v UBE Industry Sdn Bhd & Anor [2001] 1 CLJ 30 (refd)

Legislation referred to
Trade Marks Act 1976 s 82(2)
Trade Descriptions Act 1972

SF Wong (S Indran with him) (Shearn Delamore & Co) for the plaintiffs.
Tai Foong Lam (Lee Hishammuddin Allen & Gledhill) for the defendants.

Ramly Ali J:

[1] The plaintiffs' claim against the defendant is one in the tort of passing off. The plaintiff's cause of action against the defendant is set out in the plaintiffs' statement of claim dated 28 December 1998.

PLAINTIFFS' CASE

[2] The first plaintiff is a private limited company incorporated under the laws of Malaysia with its registered office at No 114–A, Jalan CM Yusuff, 30250 Ipoh, Perak Darul Ridzuan. The first plaintiff is one of the companies in a group collectively known as the 'TAMIN Group of Companies'. At all material times the first plaintiff is a manufacturer and distributor of foodstuffs which include among others, sauces, vermicelli and syrups.

[3] The second plaintiff is a private limited company incorporated under the laws of Malaysia with its registered office at 3rd Floor, 64–66, Jalan Yang Kalsom, 30250 Ipoh, Perak Darul Ridzuan. At all material times the second plaintiff is a manufacturer and distributor of foodstuffs and is an associate company of the first plaintiff and is therefore a member of the TAMIN Group of Companies.

[4] The first defendant is an individual with an address at 1835, Jalan E5/7, Taman Ehsan, Kepong, 52000 Kuala Lumpur.

A **[5]** Both the first and second defendants are trading as Perindustrian Makanan & Minuman Layang-Layang with its registered business address at 1347, Jalan 1/33A, Batu 7, Off Jalan Kepong, 52000 Kuala Lumpur. At all material times, the first and second defendants manufacture and/or carry on trading and are merchants of base syrups, flavourings and cordials of various flavours.

B **[6]** Further or in the alternative the manufacturing of the base syrups, flavourings and cordials of the defendants' business is undertaken by a contract manufacturer known as PMM Layang-Layang Sdn Bhd.

[7] The first and second plaintiffs carry on their business by manufacturing, selling
C and distributing their products by the trade mark 'TAMIN'.

[8] The trade mark 'TAMIN' was first used when the late founder of the first and second plaintiffs, Hj Tamin bin Wahi started his business in making and selling soya sauce.

D **[9]** The business of manufacturing and selling soya sauce was made under two registered businesses which were Sykt Zamani Hj Tamin and Sykt Salmi Hj Tamin since 1976.

E **[10]** The plaintiffs were incorporated in 1988 to acquire and take over the businesses of Sykt Zamani Hj Tamin and Sykt Salmi Hj Tamin including the goodwill of the business associated thereto and to handle the business activities relating to the manufacturing, selling and distributing of goods bearing the trade mark 'TAMIN'.

F **[11]** The plaintiffs since 1988 are in the business of manufacturing, producing, trading, selling and distributing the goods so marked with the said mark 'TAMIN' which among others include chili sauce, tomato sauce, soya sauce, syrups, noodles, vermicelli, salted beans and other foodstuffs.

G **[12]** By virtue of the extensive sales and trading activities of the plaintiffs since 1988 and by virtue of the long usage of the trade mark 'TAMIN' from the predecessor businesses, the goodwill and reputation therewith associated have since been acquired by the plaintiffs. The plaintiffs have established themselves as reputable businesses and have built considerable goodwill jointly and severally for their business
H in the goods which they manufacture, supply, sell and offer for sale by reference to the trade mark 'TAMIN'.

[13] The goodwill, reputation and commercial advantage acquired by the plaintiffs are joint and several and being members of the 'TAMIN' group of companies jointly and severally enjoy the exclusive right to the exploitation thereof.

I **[14]** The plaintiffs have jointly and severally conducted extensive sales in addition to extensive promotional activities. The plaintiffs' markets for such goods not only cover the whole of Malaysia but also extend to foreign countries amongst which are Japan, Singapore and Vietnam.

[15] By virtue of the considerable sales of the plaintiffs' goods as well as the extensive advertisement and promotional efforts undertaken by reference to the said mark and the joint and several goodwill and reputation associated therewith the plaintiffs' business, the trade mark 'TAMIN' has become distinctive in the sense amongst which it is distinctive of the plaintiffs in relation to their trade and business in the goods manufactured, sold and traded by them.

[16] The defendants in the course of their trade and business have been manufacturing and/or have manufactured for sales, distributing and selling their cordials, flavourings and syrups bearing the word 'TAMIN' identical and/or confusingly and colourably similar to the plaintiffs' trade mark 'TAMIN'.

[17] By virtue of the identical nature of the marks and by reason of the fact that the goods of interest to which the respective 'TAMIN' marks were employed in relation to are the same or of the same description, the acts of the defendants would invariable lead to confusion and deception. The unsuspecting trade and purchasing public would be misled into the false supposition that the goods of the defendant are associated, affiliated or connected with the plaintiffs.

[18] The particulars of passing off relied upon by the plaintiffs relate to the manufacture, sale and distribution and the general exposure to the public of goods bearing the offending 'TAMIN' trade mark. The plaintiffs have never authorised or licenced the acts of the defendants.

[19] As a result of the defendants' acts of passing off committed against the plaintiffs, the plaintiffs suffered loss and damage and now pray for the following reliefs:

(1) An injunction to restrain the defendants, whether acting by their directors, officers, servants or agents or any of them in combination or otherwise howsoever from doing the following acts or any of them, that is to say:

(a) passing off or attempting to pass of syrups and other goods of a similar description by the manufacture, supply, distribution sales and offer for sales of the same with the trade mark 'TAMIN' or any other trade mark which is deceptively and confusingly similar thereto;

(b) unlawfully appropriating the plaintiffs' goodwill, reputation and commercial advantage in the field of trade and business relating to sauces and other products of a similar description or assisting any others to do so by the manufacture supply, distribution sales and offer for sales of the same the trade mark 'TAMIN' or any other trade mark which is deceptively and confusingly similar thereto; and

(c) An Order for full discovery of all relevant documents particularly invoices, contracts, customers' records, sales records, delivery orders, customer declaration forms and shipping documents and other documents relating to the defendants' manufacture, supply, distribution sales and offer for sales of the same the trade mark 'TAMIN' or any other trade mark which is deceptively and confusingly similar thereto;

(2) An order for delivery up to the plaintiffs or its solicitors or authorised agents for destruction of all the offending goods bearing the 'TAMIN' trade mark in the possession, custody, power or control of the defendants;

(3) Inquiry as to damages or at the plaintiffs' option an account of the defendants' profits in respect of their passing off acts;

(4) Interest;

(5) Costs; and

(6) Such further and other relief as the court may deem fit.

DEFENDANTS' CASE

[20] The defendants in their defence raised the following points and defences:

(i) Denied that the plaintiffs were manufacturers of syrup;

(ii) Denied that the plaintiffs had goodwill and reputation in their business with reference to the 'TAMIN' trade mark;

(iii) Averred that the plaintiffs were not the proprietors of the 'TAMIN' trade mark as the trade mark was assigned by Hj Tamin bin Wahi to Sharifah bte Hj Tamin. The plaintiffs being mere licencees were thus not the proprietors of the goodwill and reputation in respect of the 'TAMIN' trade mark;

(iv) Denied that the 'TAMIN' trade mark was distinctive of the plaintiffs;

(v) Denied that the defendants' 'TAMIN' trade mark was confusingly and deceptively similar to the plaintiffs' 'TAMIN' trade mark;

(vi) The defendants claimed that they had used 'TAMIN' since 1991 and they were the first in time to use 'TAMIN' in relation to syrups and cordials.

(vii) That by virtue of their first use of 'TAMIN' in relation to syrups and cordials, 'TAMIN' was distinctive of them.

[21] The defendants further counter claimed against the plaintiff on the following basis:

(i) That the plaintiffs by using 'TAMIN' in relation to cordials, syrups and flavourings had passed off their products as and for the products of the defendants;

(ii) The defendants contentions were premised on the fact that they were the first in time to use 'TAMIN' in relation to syrups, cordials and flavourings; and

(iii) The plaintiffs had committed slander to title and to the goods of the defendants by lodging complaints with the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs resulting in the Enforcement Division raiding the defendants' premises and seizing the defendants products bearing the 'TAMIN' trade mark.

[22] Pursuant to the counter claim, the defendants prayed for the following remedies:

(1) A permanent injunction to restrain the plaintiffs, whether by their directors, officers, servants or agents or any of them or otherwise howsoever from doing the following acts or any of them, that is to say:

(a) using any trade mark which includes the word 'TAMIN' or any colourably similar word in relation to cordials, flavourings and syrups;

(b) manufacturing, importing, distributing, selling or offering for sale cordials, flavourings and syrups bearing the trade mark consisting to the word 'TAMIN' not being the products of the defendants;

(c) advertising in any form whatsoever cordials, flavourings and syrups bearing the trade mark consisting of the word 'TAMIN' not being the products of the defendants;

(d) passing off or attempting to pass off or causing, enabling or assisting others to pass off cordials, flavourings and syrups not the cordials, flavourings and syrups of the defendants as and for the cordials, flavourings and syrups of the defendants;

(2) An Order for the erasure, removal or obliteration, upon oath, from all infringing goods, material or articles in the possession, custody or control of the plaintiffs of any label/advertisement consisting of the word 'TAMIN' used as a trade mark in relation to cordials, flavourings and syrups;

(3) An Order for the delivery up to the defendants, or such other person as the court may direct, of all infringing goods, material or articles in the possession custody or control of the plaintiffs, and directions for the disposal thereof by destruction or forfeiture to such person as the court may think fit;

(4) A permanent injunction to restrain the plaintiffs, whether by their directors, officers, servants of agents or any of them or otherwise howsoever from further publishing:

(a) false statements concerning the defendants right to manufacture, produce, distribute and sell cordials, flavourings and syrups bearing the defendants' 'TAMIN' trade mark; and

(b) misstatement reflecting adversely in the authenticity of the defendants' said products;

(5) An inquiry as to damages or at the defendants option an account off profits in respect of the plaintiffs' acts of passing of and payment of all sums found due upon taking such inquiry or account together with interest thereon at such rate and for such period as this court deems fit;

(6) Damages for slander of goods and slander of title;

(7) Interest;

(8) Costs; and

(9) Such further or other relief and directions as this court deems fit and just.

[23] The plaintiff in their reply and defence to counter claim joined issue with the defendants. In specially addressing the issues in the defendants' counter claim, plaintiffs averred as follows:

(i) The plaintiffs contended that 'TAMIN' was distinctive of them and not the defendants. Thus the issue of confusion and deception would arise out of the acts of the defendants and not the plaintiffs;

(ii) The plaintiffs denied that they passed any disparaging remarks with regard to the defendants' goods; and

(iii) The plaintiffs had acted in a bona fide manner in enforcing their rights and thus their complaints made to the Enforcement Division were well within their rights to protect their legitimate expectations.

[24] It was clear that at the point of the exchange of pleadings, there were significant disputes of facts and law. After the close of pleadings and after case management, the parties agreed on the following as admitted facts:

(i) The particulars of the parties as set out in the statements of claim were admitted;

(ii) The defendants in the course of the business sold, distributed, supplied and offered for sales articles of drink such as cordials and syrups bearing the 'TAMIN' trade mark; and

(iii) The usage of the 'TAMIN' trade mark by the defendants were focused on the east cost where the majority of the population were Malays.

[25] With the above backdrop in mind, it would be useful to examine the testimony of the relevant witnesses tendered during the course of the trial.

EVIDENCE OF THE PLAINTIFFS' WITNESSES — PW1

Sharifah bte Hj Tamin

[26] The essential elements of the evidence in chief of PW1 which dealt with the history of usage of the 'TAMIN' trade mark and the expansion of its use and the action taken against the defendants could be summarised and set out as follows.

[27] PW1 was the executive chairman of the plaintiffs and her responsibilities included general administration, accounts and marketing. PW1 however stressed that she was not responsible for production or quality control of the products produced by the plaintiffs.

[28] The plaintiff were incorporated in 1988 to take over the businesses of Sykt Salmi Hj Tamin and Sykt Zamani Hj Tamin. This is evidenced by the memorandum and articles of association of the plaintiffs marked as exhs P1 and P2. The nature of the plaintiffs' business is the manufacture, distribution and sales of various articles of food and drink all of which carry the 'TAMIN' trade mark. PW1 relied on exhs P3 and P4 which were the plaintiffs brochures showing the usage of the 'TAMIN' trade mark in relation to a wide range of products.

[29] The 'TAMIN' trade mark was used by the plaintiffs as it represented the trade marks used by the plaintiffs' predecessors for a substantial period of time. PW1 then went on to show the history of the usage of the 'TAMIN' trade mark. It all started when the late father of PW1, Hj Mohd Tamin bin Mat Wahi started his business in 1951. 'TAMIN' was used as a trade mark as it represented the name of Hj Tamin bin Wahi and it was only sensible that the business presented the identity of the founder ie his own name. The business started of as producing and selling 'kicap'. The subsequent expansion of the operation resulted in the setting up of Sykt Salmi Hj Tamin and Syarikt Zamani Hj Tamin which were the plaintiffs' predecessors. It is important to note that the businesses of Sykt Salmi Hj Tamin and Sykt Zamani Hj Tamin took over the business of Hj Tamin which was the plaintiffs' original predecessor in title. It is further pertinent that PW1 had been involved in the businesses of the plaintiffs since its incorporation and in the businesses of the plaintiffs predecessors in title for a considerable period of time where she helped her father in the said businesses.

[30] Early use of the 'TAMIN' trade mark by the Hj Tamin and the plaintiffs' other predecessors in title were seen in pp 13 to 19, 163 of Bundle B1, and various early invoices of the sale of the products bearing the 'TAMIN' trade mark (exhs P8 and P9). As can be seen, this was clear evidence to show the wide usage of 'TAMIN' in relation to a wide range of different food and drink products.

[31] When the plaintiffs took over the businesses and goodwill of Sykt Salmi Hj Tamin and Sykt Zamani Hj Tamin, they also took over the rights to the usage of the 'TAMIN' trade mark as the 'TAMIN' trade mark signified a major asset of the business of the plaintiffs' predecessors. PW1 further admitted that she does not use 'TAMIN' in her personal capacity and admitted that the goodwill and reputation of the business to which the 'TAMIN' trade mark was used belonged to the plaintiffs.

[32] PW1 then introduced the range of products used by the plaintiffs which were marked as court exhs P12 to P33. As the evidence showed, this expansion was constant and consistent since 1951 and the plaintiffs and their predecessors in title gained significant goodwill and reputation in their business with regard to the usage of the 'TAMIN' trade mark. The trade mark and purchasing public have come to recognise the 'TAMIN' trade mark as the plaintiffs' trade mark and articles of food and drinks bearing the 'TAMIN' trade mark would naturally be associated with the plaintiffs. Although kicap was the first product produced, the evidence as led clearly illustrates the point that 'TAMIN' was used in relation to a wide range of food and drink products. As can be seen from some of the early invoices, the plaintiffs' predecessors had used 'TAMIN' in relation to various goods from the 1980s which was well before the usage of 'TAMIN' by the defendants. Further PW1 testified that the usage of the 'TAMIN' trade mark vis a vis the Kelantan market started since the 1980s although the presence of the plaintiffs and/or their predecessors was not that extensive.

[33] With reference to syrups and cordials, the plaintiffs predecessors had been using 'TAMIN' as a source identified since the 1980s.

[34] The usage of 'TAMIN' in relation to syrups and cordials was continued by Maju Tamin (M) Sdn Bhd, in the 1990s.

[35] PW1 further explained instances of infringements of the 'TAMIN' trade mark and actions that had been taken to protect their rights thereto.

[36] In relation to the defendants, the testimony of PW1 showed that the plaintiffs became aware of the defendants in 1996 when one of the other companies within the group, Maju Tamin (M) Sdn Bhd received a demand letter from the defendants' solicitors. The demand letter essentially required the Maju Tamin (M) Sdn Bhd to stop the usage of the 'TAMIN' trade mark in relation to syrups and cordials.

[37] The plaintiffs obviously surprised with such an action responded immediately and swiftly stating that the 'TAMIN' trade mark was theirs given their very long usage of the said trade mark in Malaysia. They thus demanded that the defendants cease the usage of the 'TAMIN' trade mark. As no further response was received from the defendants, the plaintiffs assumed that the defendants had discontinued the usage of 'TAMIN'.

[38] However, when the plaintiffs sought to extend and expand their operation further in Kelantan, they discovered that the defendants' 'TAMIN' trade mark was still being used in relation to articles of drink.

[39] After having difficulties locating the defendants by reason of a wrong address on the label and after investigations which revealed the nature of the operations of the defendants, the plaintiffs decided to utilise the criminal enforcement approach by using the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs to conduct raids at the defendants premises to seize infringing goods. Other than the infringements to the plaintiffs rights to the 'TAMIN' trade mark, the complaint by the plaintiffs were also premised on other infringements by the defendants. Firstly, the defendants had wrongly indicated their address. Secondly, the defendants had misled the public by incorporating the 'R' symbol next to their 'TAMIN' trade mark when the said trade mark had yet to secure registration. Raids were subsequently conducted by the Enforcement Division on 26 November 1998 where the defendants' infringing articles were seized.

[40] To further protect their rights, the plaintiffs commenced this action.

[41] The evidence of PW1 clearly shows that the 'TAMIN' trade mark had been used for a substantial period of time by the plaintiffs and their predecessors in title. The evidence of PW1 further illustrates the extension of the goods of the plaintiffs to cover a variety of food and drink related products all of which carry and bear the 'TAMIN' trade mark. This is evident from exhibits tendered in court by PW1.

[42] The defendants counsel's theme of attack on the evidence of PW1 took the following approach:

(i) Kicap was the main product of the plaintiffs and the extension of the goods to cover other goods only occurred recently;

(ii) Drink related products bearing the 'TAMIN' trade mark whereby introduced in mid 1990's; and

(iii) The 'TAMIN' trade mark belonged to PW1 and not the plaintiffs.

[43] The evidence of PW1 clearly demonstrates otherwise and can be shown as follows:

(i) if the early invoices of the plaintiffs' predecessors are to be examined, it is clear that the 'TAMIN' trade mark had not been used in relation to kicap only but to a variety of products. Although the plaintiffs extended their usage of 'TAMIN' from very early on, there is evidence from at least the early 1980s showing usage of TAMIN in relation to a variety of products not just limited to kicap;

(ii) PW1 also clearly stated that the 'TAMIN' trade mark had been used in relation to rose syrups since the 1980s. This would be seen to be corroborated by the defendants' witnesses, particularly DW6 later on; and

(iii) Whilst the registered 'TAMIN' trade marks were in the name of PW1, this would not effect rights to the mark in common law.

PW2 — Ahmad Zamzuri bin Nek

[44] The evidence of PW2 can be summarised as follows:

(i) PW2 was and is the Senior Group Manager of the plaintiffs and has been employed with the plaintiff since 1997. He was and is responsible for the general administration of the plaintiffs. By virtue of his position, PW2 had personal knowledge of the affairs of the plaintiffs as well as access to all relevant documents of the plaintiffs and their predecessors in title;

(ii) PW2 gave evidence on the nature of the plaintiffs' operations which were the businesses of manufacturing, selling and distributing various items of food and drink;

(iii) PW2 further confirmed that the plaintiffs took over the businesses which were originally formed by the late Hj Tamin bin Mat Wahi. The first products introduced by the plaintiffs' predecessors in title were kicap and with the increase in the business of the plaintiffs' predecessors, products such as tauchu, vermicelli, kerisik, cencaluk, sup tulang, chili and tomato sauces, vinegar and various other items of food and drink were added to the plaintiffs' range of products. The said products of the plaintiffs were manufacturd in their factories in Batu Gajah and Enggor (in Perak) respectively and approximately 140 workers were employed at the said factories. The plaintiffs' products were all identified by reference to the 'TAMIN' trade mark. The trade mark was first used by Hj Tamin and had very encouraging demand. This resulted in goodwill and reputation to the businesses of the plaintiffs and their predecessors in title and meant that the 'TAMIN' trade mark was an important asset retained by the plaintiffs when they took over the businesses of their predecessors in title. This meant the continued usage of the 'TAMIN' trade mark was crucial and important to the continued success of the businesses of the plaintiffs;

(iv) By relying on invoices and the audited accounts of the plaintiffs as well as from personal experience, PW2 gave evidence of the extensive sales and promotion of the plaintiffs; and

(v) By virtue of this extensive sales and promotion of products bearing the 'TAMIN' trade mark in Malaysia, 'TAMIN' has clearly come to be recognised as the trade mark of the plaintiffs and their predecessors in title and companies within their group. It is thus the source identifier of the plaintiffs' products. PW2 then testified that by reason of this, any unauthorised use of the 'TAMIN' trade mark such as the use by the defendants would result in damage to their goodwill and reputation.

[45] PW2 was cross examined by the defendants' counsel. The pertinent points and issues that arose from the cross examination could be summarised as follows:

(i) PW2 confirmed that the plaintiffs are currently producing more that 45 items of food and drink products. Of this 45 items, the only new products introduced after 1997 by the group were asam jawa, flour, soun, ceriping pedas, drinking water, kuah rojak, cili garlic. It is pertinent to note that cordials and syrups bases were produced before 1997. Taken together and corroborated by the evidence of PW1, it is clear that cordials and syrup bases were produced by the plaintiffs, their predecessors in title and companies within the group for a substantial period of time since the 1980s; and

(ii) Defendants' counsel then spent the greater part of the cross examination trying to suggest that the 'TAMIN' trade mark belonged to PW1 and not the plaintiffs. Various registrations in the name of PW1 for the 'TAMIN' trade mark was referred to PW2.

[46] In re-examination, PW2 confirmed that the 45 products produced by the plaintiffs all carry the 'TAMIN' trade mark.

PW3 — Mohamad Rashid Ali

[47] PW3 is the marketing executive of the plaintiffs. His evidence can be summarised as follows:

(i) PW3 has been in the employ of the plaintiffs since 1999. His responsibilities at the plaintiffs included sales and marketing and consideration and investigation of new markets;

(ii) Before his employment with the plaintiffs, PW3 was employed as a cook at the Genting Highlands Resort (in the period between 1979 and 1981). Subsequently to that, he was employed at A Clouet in the marketing division relating to food products;

(iii) PW3 testified that he became aware of products bearing the 'TAMIN' trade mark for more than 25 years since he was a cook in Genting Highlands. He had personally used products bearing the 'TAMIN' trade mark produced by the plaintiffs and was very satisfied with the said products. Further, through out his employment with A Clouet, he was involved in the marketing of products bearing the 'TAMIN' trade mark. PW3 confirmed that he obtained

the said products from the plaintiffs and the plaintiffs predecessors in title and the said products were marketed through out the country and in some cases even exported to foreign countries. By virtue of the plaintiffs said use of the 'TAMIN' trade mark, PW3 testified that such use of the mark would be associated with the plaintiffs; and

(iv) PW3 became aware of the presence of the defendants 'TAMIN' products since he joined the plaintiffs in 1999. He further received complaints from a few retailers whilst he was conducting his duties in the course of his employment with the plaintiffs. In one such instance, a manager of D-Mart in Seremban returned the defendants products bearing the 'TAMIN' trade mark to PW3 on the basis of its unsatisfactory quality. Although PW3 informed the said manager that the products did not originate from the plaintiffs, the said manager was adamant claiming that the products bore the 'TAMIN' trade mark and thus it should be returned to the plaintiffs, the known producers of products bearing the 'TAMIN' trade mark.

[48] In cross-examination and re-examination, PW3 maintained his long knowledge of the plaintiffs' 'TAMIN' trade mark even before he joined the plaintiffs. He further reiterated the incidence of confusion and deception that would arise by reason of the presence of the defendants' products bearing the 'TAMIN' trade mark in the market.

[49] The evidence of PW3 is important for two reasons. Firstly it establishes the plaintiffs and their predecessors in title as the parties which have been using the 'TAMIN' trade mark in relation to a variety of food and drink articles for a substantial period of time. PW3 from personal experience had been using the plaintiffs' products bearing the 'TAMIN' trade mark for more than 25 years. He had further been involved in the marketing of the plaintiffs' 'TAMIN' products even before he commenced employment with the plaintiffs (when he was employed at A Clouet).

[50] The second important aspect of the testimony of PW3 is the fact that there is and was incidence of confusion and deception by the presence of the defendants 'TAMIN' products in the market. An actual event relating to the manager of D-Mart was related which was a case where the plaintiffs were wrongly associated to the products of the defendants bearing the 'TAMIN' trade mark.

[51] The evidence of PW3 thus clearly shows that the 'TAMIN' mark was first used by the plaintiffs and their predecessors in title and such use has been extensive and in relation to various articles of food and drink. The evidence further who was that the plaintiffs and their predecessors have significant goodwill and reputation in their business with reference to the 'TAMIN' trade mark. This goodwill and reputation has been damaged by the acts of the defendants by reemploying 'TAMIN' in relation to their products and the trade and public wrongly associating the defendants products bearing the 'TAMIN' trade mark with the plaintiffs.

PW4 — Abdullah bin Man

[52] The evidence of PW4 relates essentially to the degree of confusion and deception that would arise by reason of the presence of the defendants products bearing the 'TAMIN' trade mark. The pertinent aspects of the evidence in chief of PW4 are as follows:

(i) PW4 is currently self employed as a roti canai maker. He had been aware of the 'TAMIN' trade mark since 1985 when he was working at TLDM Lumut. The 'TAMIN' products that he had been using at that time were kicap and tauchu. He was aware at that tine that these products bearing the 'TAMIN' trade mark were produced by Sykt Zamani Hj Tamin and Sykt Salmi Hj Tamin. (Incidentally these were the plaintiffs predecessors in title).

(ii) By virtue of his knowledge of the plaintiffs and the 'TAMIN' trade mark, the 'TAMIN' trade mark as far as he was concerned was associated with the plaintiffs. He was also aware that the 'TAMIN' trade mark was used in relation to a wide range of food and drink products all of which he associated with the plaintiffs; and

(iii) He became aware of the defendants products bearing the 'TAMIN' trade mark when he returned to Kelantan in 1998. Whilst he was buying items for his restaurant, he noticed a syrup base product bearing the 'TAMIN' trade mark. As he was accustomed to using 'TAMIN', he immediately purchased the product without any suspicion that it did not originate from the plaintiffs. He later discovered that the said product that he purchased was produced by the defendants. PW4 identified the defendants said offending product bearing the 'TAMIN' trade mark as the product similar to what he had purchased. He admitted to being confused into believing that the said product of the defendants bearing the 'TAMIN' trade mark was associated with the plaintiffs. As food and drink products have a similar purpose and are sold through the same trade channels, confusing the source of products of the defendants bearing the 'TAMIN' trade mark as the plaintiffs' products was unavoidable and inevitable.

[53] In cross examination, the evidence of PW4 was not seriously challenged and he maintained the position taken in examination in chief. In re-examination PW4 confirmed that he used P38 which was the defendants' 'TAMIN' product because it bore the 'TAMIN' trade mark.

PW5 — Abd Latif bin Mohamad

[54] The evidence of PW5 had the following pertinent facts:

(i) PW5 who is currently retired used to have a business selling food items;

(ii) PW5 testified that he had been aware of the 'TAMIN' trade mark from the 1980s. At that time he had been selling kicap, chili and tomato sauces bearing the 'TAMIN' trade mark to some provision shops in Kelantan and Terengganu. The supply of these 'TAMIN' products according to PW5 was obtained from Sykt Salmi Hj Tamin and Sykt Zamni Hj Tamin (both these businesses were the plaintiffs' predecessors in title);

(iii) PW5 stated that the 'TAMIN' products which originated from the plaintiffs had good demand as the food items were good tasting. PW5 himself had used the plaintiffs' 'TAMIN' products for his personal consumption and he had been very satisfied with the said products; and

(iv) PW5 confirmed that the products were obtained from the plaintiffs and/or the predecessors in title and insofar as he was concerned, when 'TAMIN' as a trade mark was used in relation to items of food and drink, he would immediately associate it with the plaintiffs and the quality of products that he had come to expect of the plaintiffs.

[55] In cross examination, PW5 maintained the stand taken during examination in chief. Further to that he made the following observations:

The pertinent aspects of DW1 evidence are as follows:

(i) He ordered his 'TAMIN' branded products directly from the plaintiffs and their predecessors in title. As a matter of fact, he had been to the plaintiffs' factories; and

(ii) When referred to the products of the plaintiffs tendered as exhibits, PW5 stated that whilst he could not remember the get-ups of some of the articles, he knew that the products that he purchased and sold on to retailers in Kelantan and Terengganu originated from the plaintiffs and their predecessors in title.

EVIDENCE OF THE DEFENDANTS' WITNESSES

DW1 — Yong Sze Fan

[56] The pertinent aspects of DW1 evidence are as follows:

(i) The plaintiffs' products and the defendants' products are potentially sold in the same retail stores;

(ii) Save that when he first introduce 'TAMIN' in relation to syrups produced by the defendants, he had never been to the sauce sections in supermarkets, although he had been to supermarkets before 1990;

(iii) DW1 stated that when the first started using 'TAMIN' in relation to his drink products, no other person had been using the said trade mark in relation to those goods;

(iv) DW1 then went on to introduce as exhibits the various products of his (which were drink products only) all of which employed the 'TAMIN' trade mark;

(v) The choice of the usage of 'TAMIN' according to DW1 was that TAMIN' represented a harvesting knife and this would consequently bring luck to his business;

(vi) DW1 introduced evidence of usage of the 'TAMIN' trade mark by relying on sales and promotional activities of the defendants. The defendants activities were however concentrated in the state of Kelantan;

(vii) DW1 then gave evidence as to when he became aware use of the 'TAMIN' trade mark by other parties in relation to rose syrups particularly drawing reference to the usage of 'TAMIN' by Maju Tamin (M) Sdn Bhd. According to DW1, he only became aware of such use in 1996 and he took action in this regard by instructing his solicitors to issue a demand letter to Maju Tamin (M) Sdn Bhd;

(viii) DW1 however did not take further action upon receipt of the response from the solicitors of Maju Tamin (M) Sdn Bhd. The response by Maju Tamin (M) Sdn Bhd essentially was that 'TAMIN' belonged to the plaintiffs and their group of companies and it was the defendants who should cease the usage of the 'TAMIN' trade mark. DW1 then found out that Maju Tamin (M) Sdn Bhd was related to another company who had been using 'TAMIN' in relation to kicap; and

(ix) The rest of the evidence in chief of DW1 was in relation to enforcement action taken against their usage of the 'TAMIN' trade mark. Although DW1 set out the losses that the defendants suffered as a result of the raid done by the enforcement division, the losses suffered were not independently verified.

[57] In cross-examination, DW1 confirmed the following:

(i) The plaintiffs' products and the defendants' products are potentially sold in the same retail stores;

(ii) Save that when he first introduce 'TAMIN' in relation to syrups produced by the defendants, he had never been to the sauce sections in supermarkets, although he had been to supermarkets before 1990;

(iii) Save that when he first introduce 'TAMIN' in relation to syrups produced by the defendants, he had never been to the sauce sections in supermarkets, although he had been to supermarkets before 1990;

(iv) When 'TAMIN' was first used by the defendants, they already had a very successful trade mark called 'Layang-Layang' which was used in relation to syrup bases. Although DW1 said that 'TAMIN' signified a different viscosity of the drink compared to 'Layang-Layang', this was not informed to the trade and purchasing public.

DW2, DW3, DW4, DW7, DW8, DW9 AND DW10 — TRADE AND CONSUMER WITNESSES

[58] These witnesses can be dealt with together as all of them are trade and consumer witnesses who had been called to give evidence as to their awareness of the 'TAMIN' trade mark. Similar questions were posed to them during examination in chief and almost identical answers were given in reply.

[59] What is more important is that the witnesses interviewed all were from Kelantan. There was not even the slightest attempt to obtain balanced evidence on the presence of the respective usage of the 'TAMIN' trade mark by the parties through out the country. After all the goodwill and reputation and the remedies

prayed by the parties cover the whole country and is not simply confined to Kelantan. This has to be contrasted with the plaintiffs' evidence of use of the 'TAMIN' trade mark which covers the entire country including Kelantan.

[60] In light of this, the evidence of these witnesses which are targeted mainly to show that the defendants 'TAMIN' trade mark is distinctive should be given very little weight. The evidence presented is selective in the sense that it only relates to Kelantan. Secondly these witnesses had not made any comparison with the plaintiffs' products. It may well be that based on their existing knowledge of 'TAMIN' (which had to be the plaintiffs 'TAMIN' which as the evidence showed was already in the market in Kelantan, even before the introduction of 'TAMIN' by the defendants), they would have purchased the defendants 'TAMIN' products based on their knowledge of the plaintiffs and their 'TAMIN' products.

DW5 — Abdul Rashid Abdullah

[61] The evidence of Abdul Rashid was given orally without any witness statements. The pertinent aspects of his testimony were as follows:

(i) He was employed with the defendants since 1992. He had been selling the defendants' products since then. The defendants products were obtained from the defendants factory in Kuala Lumpur;

(ii) The defendants products that he sold bore the TAMIN' and Layang-Layang trade marks; and

(iii) DW5 further gave evidence of the enforcement activities conducted against the defendants by the enforcement division of the Ministry of Domestic Trade and Consumer Affaairs. The evidence of loss caused by the enforcement action was given although without any independent verification.

DW6 — Lim Yit Foong

[62] The evidence of DW6 made reference to a survey done by Central Force Malaysia of which DW6 was a director. The pertinent aspects of the evidence of DW6 can be summarised as follows

(i) DW6 is the director of Central Force Malaysia, a company that offers market research services, specialising in the provision of fieldwork services;

(ii) On or around October 1999, DW6 was approach by Mr Tai Foong Lam, the defendants solicitor to conduct research on behalf of the defendants. The purpose of the research according to DW6 was aimed at assessing the perceptions of drink concentrate buyers as to whether there was confusion between 'TAMIN' syrups produced by Sykt Zamani Hj Tamin Sdn Bhd and 'TAMIN' syrups produced by the defendants in the Kelantan market;

(iii) The target respondents of the surveys were identified as the housewife who made the purchase for the household. The survey was further conducted in three different strata being urban, semi urban and rural;

(iv) The interviews on the respondents were conducted by interviewers hired on a part time basis and according to DW6 under the supervision of Central Force's fieldwork supervisors;

(v) The interviews were further completed within two weeks of its commencement.

(vi) 201 Malays respondents were interviewed based on prepared questions.

(vii) DW6 stated that when referring to Chart 4 at pp 375 to 378 of Bundle B6, he meant the defendants' products and in answer to question 47 of the witness statement, he stated that the survey indicates that the defendants product is the No 1 brand in Kelantan. It is important to note at this stage that the report does not indicate if the products of both parties were actually shown to the respondents of the interview;

(viii) The survey states that the defendants 'TAMIN' syrup is widely accepted by Malays in Kelantan;

(ix) Based on the questions asked, 33% had been using 'TAMIN' syrup for more than 10 years. The respondents had not been asked if it was the plaintiffs or defendants' 'TAMIN' syrup that they were referring to. No interviews were conducted after 26 March 2000;

(x) DW6 in the answer to question 61 of the witness statement said that the plaintiffs 'TAMIN' syrup is seen as a repackaging of the defendants products. No evidence was given as to the reasons for this finding;

(xi) DW6 then went on to say that most of the consumers in Kelantan recognise the defendants' 'TAMIN' products; and

(xii) With reference to Chart 12 on p 395 of Bundle B6, it is seen that 29% of the respondents say that they had been using the defendants' 'TAMIN' products for more than 10 years.

[63] In cross-examination DW6 confirmed the followings:

(i) He had not encountered any failure in his researches in the past 30 years;

(ii) The background facts of the survey were given by the defendants solicitors and DW6 did not independently verify the facts given. Among the facts given were that the plaintiffs were soya sauce manufactures. No information was given as to the other range of products produced by the plaintiffs;

(iii) DW6 mentioned that the defendants' solicitor gave the target consumers of the defendants products but not the target consumers of the plaintiffs products;

(iv) No interviews were conducted after 26 March 2000;

(v) The inverviewers hired by him had not done a survey with a similar objective before;

(vi) Although he did not know how many men and how many women were interviewed, he agreed that most of the target respondents would have been women;

(vii) DW6 confirmed that both he and his wife did grocery shopping and he did buy cordial drinks and kicap products as well in the past;

(viii) DW6 agreed that the interviews asked the questions in the order and sequence set out in the questionnaire in the survey;

(ix) DW6 agreed that none of the respondents were asked as to which 'TAMIN' products (whether the plaintiffs or the defendants) were the first in time;

(x) DW6 did not have details of the persons interviewed; and

(xi) DW6 agreed that some of the respondents in replying to the questionnaire (question 2a) in p 437 of Bundle 6 would have been referring to the plaintiffs' 'TAMIN' products.

(xii) No interviews were conducted after 26 March 2000;

COURT'S OBSERVATIONS ON DW6'S EVIDENCE

[64] The evidence of DW6 made reference to a survey done by Central Force Malaysia of which DW6 was a director. The court is of the view that the evidence of DW6 should be viewed with great caution for the following reasons:

(i) The survey was premised on the background facts given by the defendants' solicitors. As a person accustomed to doing surveys, DW6 should have independently verified the facts given prior to him conducting the survey. Otherwise it would have been very unlikely that the survey would have given a balanced position;

(ii) The survey did not address the other products of the plaintiffs all of which carried the 'TAMIN' trade mark. It was only focused on soya sauce and syrups;

(iii) The survey was conducted in Kelantan only. Therefore, it can hardly be said that the defendants 'TAMIN' products were more distinctive than the plaintiffs 'TAMIN' products through out Malaysia. For a more balanced survey evidence, the survey should have been carried out through out the country. After all the remedies prayed by the parties (in the claim and counter claim) covered injunctive remedies and such remedies were not confined to the territorial boundaries of Kelantan;

(iv) The survey seems to have been deliberately conducted in Kelantan to ensure that the survey arrives at a conclusion that is more favourable to the defendants. (Even so for reasons set out below, the survey seems to confirm certain details favourable for the plaintiffs);

(v) The survey targeted respondents which commonly buy the defendants products. Only Malay housewives were interviewed. This is despite the fact that persons other than the Malay housewives would also buy kicap and syrup products. In fact DW6 himself confirmed that he would buy such products. DW6 could hardly be classified as a Malay housewife;

(vi) What is most amusing is that DW6 stating that the income group of the respondents would not have a bearing on the survey. This is highly questionable as different income groups would certainly have different

purchasing patterns With this mind, it is difficult to accept that DW6 had conducted various surveys over a period of 30 years without failure. If DW6 could not have considered such important but simple issues, how can we accept his boast of his success rates? The credibility of his evidence is thus highly questionable;

(vii) DW6 had not conducted the interviews personally. He based his findings on the results of the interview. Despite this, he was brave enough to suggest certain conclusions (for example the defendants 'TAMIN' being the original 'TAMIN' and that the defendants' 'TAMIN' was the first in time) although none of the questions and answers given in the survey pointed to that direction; and

(viii) His conclusions that the defendants' 'TAMIN' was the original 'TAMIN' was further later proven to be incorrect. Original suggests first in time and clearly the survey taken with the testimony of the other witnesses conclusively establishes that the plaintiffs and/or their predecessors in title were the first in time to use the 'TAMIN' trade mark in relation to even syrups not to mention the wide range of other items of food and drink.

[65] A close scrutiny of DW6's evidence further pointed favourably to the plaintiffs in the following way:

(i) It confirmed that the plaintiff products bearing the 'TAMIN' trade mark were in the Kelantan market before the introduction of 'TAMIN' by the defendants (although the plaintiffs admitted that such presence was not that extensive);

(ii) The evidence showed that at the time of the interview, a significant number of respondents had been using TAMIN' syrups for more than 10 years. As at the time of the interview, the defendants' 'TAMIN' products had not been introduced for more than 10 years, the respondents to the interview must have been referring to the plaintiffs' 'TAMIN' syrups. This is corroborated by the evidence of PW1 who stated that the plaintiffs and/or their predecessors in title had introduced 'TAMIN' in relation to syrups since the 1980s. This is further taken together with the evidence found on pp 581, 591, 593, 594, 638 and 640 of Bundle B6 which clearly shows the presence of 'TAMIN' in relation to syrups in the Kelantan market before its introduction by the defendants; and

(iii) The conclusion that the defendants 'TAMIN' was the original and first in time cannot therefore be accurate. It is the plaintiffs which were the first in time.

[66] Based on the entirety of the evidence of DW6, although it was infact tailored to suit the needs of the defendants, the evidence supports the plaintiffs in the sense that it establishes that the plaintiffs were the first in time to use 'TAMIN' in relation to syrups as well.

[67] The proper evaluation of all the evidence as a whole (both by the plaintiffs as well as by the defendants) clearly can be summerised as follows:

(i) The plaintiffs and/or the predecessors in title were the first parties to use the 'TAMIN' trade mark in Malaysia in relation to a wide range of food and drink products;

(ii) The plaintiffs' usage of 'TAMIN' even in relation to articles of drink as the evidence clearly shows was before the use of 'TAMIN' by the defendants in relation to their products; and

(iii) The defendants had deliberately chosen the Kelantan market to escape the attention of the plaintiffs despite the fact that their business was originally set-up in the West Coast of Malaysia.

THE LAW OF PASSING OFF

[68] The plaintiffs' cause of action is founded on the common law of passing off. Passing off is premised on the principle of preventing unfair competition and to prevent one party from passing off his goods and services as that of another thereby damaging the reputation and goodwill of the second party.

[69] The traditional classic form of passing off had its roots in the case of *Perry v Truefitt* (1842) 6 Beav 66, 49 ER 749 where at p 752, Lord Longdale said:

> I think that the principle on which both the courts of law and of equity proceed, in granting relief and protection in cases of this sort, is very well understood. A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practice such a deception, nor to use the means which contribute to that end. He cannot therefore be allowed to use names, marks letters or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person. I own it does not seem to me that a man can acquire property merely in a name or mark; but whether he has or not a property in the name of the mark, I have no doubt that another person has not a right to use that name or mark for he purposes of deception, and in order to attract to himself that course of trade, or that custom, which, without that improper act, would have flowed to the person who first used, or who was alone in the habit of using the particular name or mark.

[70] In *Erven Warnick v Townsend & Sons* (1979) AC 731 at p 740, Lord Diplock stated:

> The action for what is known as 'passing off' arose in the 19th century out of the use in connection with his own goods by one trader of the trade name or trade mark of a rival trader so as to induce in potential purchasers the belief that his goods were those of the rival trader. Although the cases up to the end of the Century had been confined to the deceptive use of the trade names, marks, letters or other indicia, the principle had been stated by Lord Langdale MR as early as 1842 as being: 'A man is not to sell his own goods under the pretence that they are the goods of another man…'. Perry v Truefitt (1842) 6 Beav, 66, 73.

[71] The rationale behind the tort of passing off has been clearly explained by Lord Parker in AG Spalding & Bros v AW Gamage (1915) 32 RPC 273 in the following words:

> My Lords, the action to which the appeal arises is that is known as a passing off action, and having regard to the arguments which have been addressed to your Lordships, I think it well to say a few words as to the principle on which such actions are founded. This principle is sated by Lord Justice Turner in *Burgesss v Surges* and Lord Halsbury in *Reddaway v Banham*

in the proposition that nobody has any right to represent his goods as the goods of somebody else. It is also sometimes stated that in the proposition that nobody has the right to pass off his goods as the goods of somebody else. I prefer the former statements, for whatever doubts may suggested in the earlier authorities it has long been settled that actual passing off of a defendant's goods for the plaintiffs need not be proved as a condition precedent to relief in Equity either by way of an injunction or of an inquiry as to profits or damages. Nor need the representation be fraudulently made. It is enough that it has in fact been made, whether fraudulently or otherwise, and that damages may probably ensure, though the complete innocence of the party making it may be a reason for limiting the accounts of profits to the period subsequent to the date at which he becomes aware of that true facts. The representation is in fact treated as the invasion of a right giving rise at any rate to nominal damages, the inquiry being granted at the plaintiffs risk if he might probably have suffered more than nominal damages.'

[72] Passing off of the traditional classic form therefore protects the property in the business or goodwill of the plaintiffs likely to be injured by the misrepresentation of the defendants. The plaintiffs have to prove that they have acquired the necessary goodwill by their own endeavours or have acquired it from their predecessors who had done so. Because it is the business or goodwill that is protected, the plaintiffs owner of the goodwill can do what they like with the mark which identifies the goodwill. They can raise or lower the standards of their products, change the location of manufacturing, have the product manufactured for them, change the ingredients and even use the mark on an entirely different range of goods or services as long as this will not lead to a collision with some other trader who already used the same. The plaintiffs owner are therefore entitled to the future exploitation of their goodwill by way of expansion of their business.

[73] The House of Lords case of Reckitt & Colman Products Ltd v Borden Inc & Ors (1990) 1 All ER 873 at p 880, simplified three elements that must be proved in order for a claim in passing off to succeed. Lord Olliver said:

The law of passing off can be summarised in one short general proposition — no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements, which the plaintiff in such an actions to proved in order to succeed. These are three in number, First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying get-up (whether It consists simply of a brand name or a trade description or the individual features of labeling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplied of the goods or services is immaterial as long as they are identified with a particular source, which is in fact the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a quia timet action that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

[74] Therefore, in order to establish an action for passing off, the plaintiffs must prove the following elements:

(i) that they have sufficient reputation or goodwill in the mark, trade mark, get-up or other indicia in question in this country;

(ii) that the actions of the defendants are likely to and/or have actually caused misrepresentation; and

(iii) that the plaintiffs have suffered or is likely to suffer damage or injury to their business or goodwill as a result of the defendants' misrepresentation.

[75] The application of Reckitt & Colman Products has been followed in reported local case laws, namely (among others):

(i) H & R Johnson Tiles Ltd & Anor v H & R Johnson (M) Bhd (1998) 4 MLJ 13;

(ii) UBE Engineering Sdn Bhd v UBE Industry Sdn Bhd & Anor (2001)1 CLJ 30.

[76] It is important to note that the above tests or elements set a guideline on the requirements of passing off. It is by no means a 'be all and end all' tests. As propounded by Lord Diplock earlier in his decision in Erven Warnink, the law of unfair trading would alter depending on the way trade is conducted. The overriding principle is trade which is unfair resulting in damage to goodwill and reputation of the claimant. The test in passing off could be summarised as misrepresentation in the course of trade causing damage to the business or goodwill of the claimant. This is the classical trinity refereed to in Reckitt & Colman Ltd. This being the criteria, it is important to examine if these tests have been made out from the angle of unfair competition vis a vis the realities and present demands of trade.

[77] Before we go into the criteria, it is important to note that the property protected in a passing off suit is the goodwill of the business. The law as developed through the passage of the last century placed emphasis on the protection of the goodwill of the claimant against damage caused by the unlawful activities of the defendant. In the interest of clarity, we shall deal with each of the above conditions in turn.

GOODWILL

[78] Goodwill was explained by Lord MacNaghten in The Commissioners of Inland Revenue v Muller & Co's Mergarine Ltd (1901) AC 217 as follows:

> '… what is goodwill?
>
> It is a very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force, which brings in custom. It is the one things which distinguishes an old-established business from a new business at its start. The goodwill of a business must emanate from a particular center or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates.

[79] Lord Lindley at p 235 of the same case had this to say:

> Goodwill regarded as property has no meaning except in connection with some trade, business, or calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence of competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on.

[80] In the case of AG Spalding & Bros v AW Gamage Ltd, it was held by Lord Parker that the property that was protected in a passing off suit is goodwill. At p 284, His Lordshp said:

> there appears to be a considerable diversity of opinion as to the nature of the right, the invasion of which is subject of what are known as passing off actions. The more general opinion appears to be that the right is a right of property. The view generally demands and answer to the question — property in what?
>
> Some authorities say property in the mark, name or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in Reddaway v Banham expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think, strong reasons for preferring the latter view.

[81] Parker J in *Burberry's v JC Cording & Co Ltd* (1909) 26 RPC 693 at p 701 said:

> If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property to protect which it is granted is not property in the word or name but property in the trade or goodwill which will be injured by its use.

[82] This position that the right to be protected in a passing off suit is the goodwill in the business was subsequently accepted in the Privy Council decision of Star Industrial Co Ltd v Yap Kwee Kor (1976) 2 FSR 256 at p 269 and in the decision of Erven Warnink.

[83] It is clear from the above description that goodwill is the benefit added to the business through extensive trading operations which attracts custom. The trade mark or get up is the badge and indicia that indicates and identifies the goodwill and the business. Goodwill is created by trading activities. In essence, going back to the definition of Lord MacNagthen in *IRC v Muller*, goodwill is the benefit of a good name attached to a business. The more extensive the trading activities (which include sales and promotion) the greater the value that would be attached to the goodwill.

[84] In the set of facts of this case, it is abundantly clear that the plaintiffs and/or their predecessors in title had used the 'TAMIN' trade mark for a significant period of time. As a mater of fact, the undisputed evidence showed that 'TAMIN' was first used in 1951 by the late Hj Tamin. The earlier use of the 'TAMIN' trade mark was admittedly in relation to 'kicap'. However, since 1951, there has been considerable

extension and expansion of goods by the plaintiffs and their predecessors of the 'TAMIN' trade mark. The plaintiffs which took over the businesses run by Hj Tamin extended the use of 'TAMIN' to cover a wide range of food and drink products.

[85] The evidence of the plaintiffs having taken over the businesses of Sykt Zamani Hj Tamin and Sykt Salmi Hj Tamin is evident from the Memorandum and Articles of Association of the plaintiffs. This would also logically mean that the goodwill and reputation associated with these businesses were also taken over by the plaintiffs.

[86] It is thus without doubt that the plaintiffs having inherited the goodwill and reputation from the businesses formerly run by Haji Tamin continued to develop this goodwill and reputation and extended the range of products previously offered by the businesses run by Haji Tamin. As the 'TAMIN' trade mark had been consistently and continuously used in conjunction with the businesses of the plaitiffs, it was the badge and the indicator of the goodwill in the businesses run by the plaintiffs and their predecessors in title. The 'TAMIN' trade mark as the evidence has shown is clearly distinctive of the plaintiffs.

[87] Goodwill and reputation with reference to a trade mark can further be jointly and severally held as is the case here. Given the joint use of the 'TAMIN' trade mark by both the plaintiffs in the course of trade, the said trade mark is jointly and severally held by both of them. This concept of joint ownership in the context of the law of passing off is seen in the case of *Dent v Turpin* (1996) ER 1003 at p 1007. The plaintiffs in that case and another person carried out distinct trades at different places of business, had derived, from a common predecessor in their respective businesses, the right to use the name of 'Dent' as a trade mark. The issue was whether the plaintiff without so joining the other persons was entitled to claim against the defendant who had unlawfully used the 'Dent' trade mark without the authority of the plaintiff or the said other party. Sir W Page Wood VC in holding that the plaintiff and the other party both had rights to the 'Dent' trade mark stated as follows at p 1007:

> I have no doubt, as I have before said, that each plaintiff has an equity, in respect of the wrong done to himself, to restrain the use of the trade mark by the defendants and to have it erased from the articles on which It has been wrongfully impressed, and this even without proof of special damage. That equity, I think, could clearly be sustained by either plaintiff in a suit to which the other was not party…

[88] It is clear that the above case has some parallels with the facts of the present case. Here too the plaintiffs derived title from their predecessors. Both plaintiffs were entitled to use the 'TAMIN' trade mark and both had established goodwill and reputation in their business with reference to the 'TAMIN' trade mark. The plaintiffs therefore have the relevant and necessary locus standi to commence this action.

[89] Case law has further showed that goodwill can be shared. In the case of *Besalon International Limited & 2 Ors v South Strong Industries Sdn Bhd* (1997) 2 AMR 1333 Kamalanathan Ratnam JC held on p 1358 that:

> Notwithstanding that the law provides that a holding company and its subsidiary are different legal entities, the holding company is entitled to enforce the collective and shared goodwill of the group.

[90] It is clear form the facts of the present case, which are undisputed that the plaintiffs are part of the same group. The plaintiffs use the 'TAMIN' trade mark with certain variations. However, the use of the 'TAMIN' trade mark is clearly distinctive of both the plaintiffs within the group and is a badge and indicator of the group.

[91] The defendants main challenge to the issue of goodwill as is seen from their pleadings, their submissions as well as the manner of their cross examination was whether the plaintiffs were the true owners of the goodwill which was protected under the law of passing off. The defendants' contention was that various 'TAMIN' trade mark registrations under the Trade Marks Act 1976 (which were in any case not the subject matter of this dispute which is premised on the common law of passing off) had been assigned by the late Hj Tannin to Puan Sharifah bte Hj Tamin. The defendants further contended that the said 'TAMIN' trade mark registrations were subsequently licensed to the plaintiff. This being the case, the defendants suggested that the plaintiffs are not in the position to complain of any damage to their goodwill and reputation simply because the goodwill and reputation belonged to some other party and as mere licensees, they are not the rightful claimants.

[92] The court finds the defendants' contentions and position devoid of reality in the true sense of the word. It is an overly technical and pedantic position to take and should not be used to frustrate the case of the plaintiffs which clearly has merits. A few issues however arise out of the said contention and would be addressed in the course of these judgments.

[93] Firstly the trade marks raised by the defendants are registered trade marks under the Trade Marks Act 1976 and the licences relied upon relate to the said registered trade marks. It is important to note that the present cause of action is one in passing off and does not deal with trade mark infringements under the Trade Marks Act 1976. The law in relation to this issue is clear and straightforward. As a matter of fact, the Trade Marks Act 1976, the Act which regulates the law vis a vis registered trade marks expressly preserves the rights in passing off. In this regard, the court wishes to rely on s 82(2) of the Trade marks Act 1976:

> … nothing in this Act shall be deemed to affect the right of action against any person for passing off goods (or services) as those of another person or the remedies in respect thereof.

[94] This being the case, the defendants contentions that the registered trade marks bearing representations of 'TAMIN' are in the name of Sharifah bte Hj Tamin and licensed to the plaintiffs thus precluding the plaintiffs to institute this cause of action do not hold any water.

[95] The plaintiffs cause of action, as is abundantly clear from the pleadings, is one in passing off. Therefore, the trade mark registrations for 'TAMIN' have little or no relevance to the facts in dispute. Given the fact that the Trade Marks Act 1976

expressly preserves the cause of action in passing off, the plaintiffs rights to 'TAMIN' as a badge and indicator of their business goodwill is preserved. A

[96] The main issue would be and should be who then has the rights to the goodwill in the passing off connect. As stated above passing off protects the goodwill and reputation attached to the business of a claimant. Goodwill is generated from trading activities and consumer recognition given to an established business. As goodwill is attached to a business, one has to be conducting business to claim to have goodwill and reputation. The evidence tendered during the course of the trial clearly show that Sharifah bte Hj Tamin did not conduct business in her personal capacity. This issue and fact is not contested or disputed. The business in which the 'TAMIN' trade marks were used were that of the plaintiffs and their predecessors. It was they who generated business through their activities of manufacture, distribution, supply, offer for sale and sale of various food and drink items all bearing the 'TAMIN' trade mark. Logically therefore, it is the plaintiffs that own the goodwill and reputation attached to the businesses with reference to the 'TAMIN' trade mark. It is the plaintiffs who would suffer damages if the rights to the 'TAMIN' trade mark are infringed. It is the plaintiffs' business that would suffer from the unlawful activities of the defendants. Thus rightfully, realistically and logically it would be they who should be claiming for passing off to protect their goodwill and reputation. To hold otherwise would be to take an overly technical and pedantic approach in the mater to defeat a very good claim that the plaintiffs would have. B C D E

[97] However, even if we were to assume and accept the defendants contentions that the licenses that regulate the ownership of the registered trade marks in the name of Sharifah bte Hj Tamin equally apply to the case in passing off, the court's considerations set out hereinafter should not accord a defence to the acts of the defendants. F

[98] Although admittedly, there are decisions which support the contention that where there is a licensor/licensee arrangement, any goodwill and reputation that is generated therefrom would ensure to the benefit of the licensor, this is not necessarily a hard and fast rule and certainly does not apply where the dispute is not between the licensor and the licensee but rather with a third party. G

[99] There are various decisions which support the contention that where there is a licensor/licensee arrangement (in the contractual sense) and there is a dispute between the licensor and the licensee, goodwill generated out of the activities of the licensee remain with the licensee to entitle them to the proprietary rights to the said goodwill. H

[100] In Habib Bank Ltd v Habib Bank AG Zurich (1961) 1 WLR 1265 it was held that: I

> Where an internationally known business establishes a branch in this country through a limited company either incorporated here or abroad, it may be that technically the goodwill and reputation of that business 'belongs' to the limited company in the sense that the company may be the proper and only plaintiff in an action taken to protect it.

[101] The dispute in the above case was a dispute between the licensor and licensee and the court still held that the licensee could lay a claim on goodwill and reputation generated out of their use of the Habib trade name notwithstanding the fact that such use was on the basis of a licence given by the licensor.

[102] The position is even more certain and clear where the dispute is not between the licensor and the licensee but rather with a third party (as in the present case). In such instances, the court need not go into the relationship between the licensor and licensee which regulates the contractual arrangements between them as to how the respective trade marks are to be held. Neither would the courts entertain a technical defence raised by defendants that since the action is commenced by the licensee and not the licensor, they are free to continue with their acts of infringement. In such instances, the courts would consider the equity of the situation in the determination of the case.

[103] In the case of *DHN Food Distributors Ltd v Tower Hamlest Londin Borough Council* (1976) 1 WLR 852 (Tab 14 IAP 2), Lord Denning MR held as follows at p 860:

> We all know that in many respects a group of companies are treated together for the purpose of general accounts, balance sheet and profit and loss accounts. They are treated as one concern Professor Gower in Modern Company Law, 3rd Ed (1969) says 'there is evidence of a general tendency to ignore the separate legal entities of various companies within the group'. This is especially the case when a parent company owns all the shares of the subsidiaries so much so that it can control every movement of the subsidiaries. These subsidiaries are bound hand and foot to the parent company and must do just what the parent company says. A striking instance is the decision of the House of Lords in Harold Holdsworth & Co (Wakefield) Ltd v Caddies (1951) 1 WLR 352. So here. This group is virtually the same as a partnership in which all the three companies are partners. They should not be treated separately so as to be defeated on a technical point. They should not be deprived of the compensation which should justly be payable for disturbance. It was not necessary for them to go through conveyancing device to get it'. Golf LJ further held in the same case that '… one is entitled to look at the realities of the situation…'.

[104] The above position was accepted in the case of *Revon v Cripps* (1980) FSR 85 at p 96.

[105] The decisions set out above clearly demonstrate that even if we were to accept that the goodwill resides in Pn Sharifah bte Hj Tamin (which is not necessarily the case), this does not necessarily accord a defence to the acts of the defendants. We have seen that the parties within the group, and one cannot separate Pn Sharifah from the Tamin group of companies comprising the plaintiffs in this case. They should be treated as one and should not be defeated on a technical point or deprived of compensation which should be just payable for disturbance.

[106] The effect of such decision is to ensure that the defendants do not and cannot rely on a technicality such as this to defeat the claim of the plaintiffs. Any alleged licensing arrangements vis a vis the common law rights to the mark are arrangements between the parties (ie Pn Sharifah bte Hj Tannin and the plaintiffs).

It is not for the defendants to interfere with or use it as a means of escaping liability. The matter should be considered in the context of whether they (the defendants) have indulged in acts that could result in damage to the business and goodwill of the plaintiffs. We have seen from the evidence that the plaintiffs business is recognised by the 'TAMIN' trade mark. Much value is attached to this trade mark as a distinctive identifier of the plaintiffs' business. Whether the plaintiffs have a licensing arrangement or not with Pn Sharifah is thus only relevant in dealings between the plaintiffs' and Pn Sharifah bte Hj Tamin and not with third parties like the defendants. Vis a vis the defendants, the consideration would be whether their acts would cause damage to the business of the plaintiffs. As the evidence showed and as had been explored in these judgments this is clearly made out.

[107] In the case of *Electro Cad Australia Pty Ltd v Mejati RCS Sdn Bhd* (1998) 3 MLJ 422 the defendants argued that the second plaintiffs being mere distributors may not acquire proprietary rights to sustain an action is passing off. Kamalanathan Ratnam J when dealing with this defence held as follows at p 447:

> In any event, I have no hesitation in holding that the second plaintiff owns the goodwill in Malaysia jointly with the third plaintiff. In T Oertli AG v EJ Bowman (London) Ltd (1959) RFC 1, the court held that a licensee can own the goodwill of the business in circumstances similar to that in the case before me. In any case, PW1 has confirmed that the second plaintiff owns the goodwill in the mark in Malaysia.
>
> The defendants argued that a mere distributor may not acquire proprietary rights sufficient to sustain an action in passing off and in support relied on Hai-O Enterprise Bhd v Nguang Chan; Liquor Trader (192) 4 CLJ 1985. The Hai-O case dealt with a claim between two parties concerning genuine goods, namely, the foreign manufacturer and the importer of the said manufacturer's goods, to the trade mark. In the case before me, the defendants are not concerned with the genuine goods. In Haw Par Bros International Ltd, the court brushed aside as a mere technicality the defendants challenge to the ownership of the mark. Similarly, I intend to brush aside as a mere technicality the present defendants' challenge to the ownership of the mark whether by the second or third plaintiffs because the issue of ownership between the second and/or third plaintiff is not for the defendants to question.

[108] In Chao Hick Tin J at p 438 relied on passages from Kerly on the Law of Trade Marks and Trade Names which stated that:

> … the objection that an importer has no independent goodwill, so often successful when raised on behalf of a manufacturer or of a trader dealing in the manufacturer's own goods, is likely to be brushed aside as a meek technicality when made by a defendant having no connection with the genuine goods.'

[109] These decisions have a few parallels with the case in hand. Firstly, there are admissions by Pn Sharifah that the goodwill resides with the plaintiffs jointly and severally by reason of their extensive use of their mark. Secondly, the plaintiffs in this case are more than mere distributors. For a vast majority of the products, they are the manufacturers, distributors, suppliers and sellers. Thus if in Electro Cad the court held that there could be goodwill attached, there is no reason for a different finding to be arrived at in this case. What is more important is the court's willingness to brush off mere technicalities similar to what the defendants are raising in this case and look

at the reality of the situation. The court took the position that the issue of ownership vis a vis parties within the same group was not for the defendants to question as they had no connection whatsoever with the genuine goods.

[110] The defendants should not be allowed to rely on technicalities such as this to cloak their obvious infringing activities. This would result in an absurdity especially since in this case Pn Sharifah bte Tamin (who the defendants say should be the rightful owner) has acknowledged that the goodwill and reputation which is the property protected in the passing off suit resides in the plaintiffs

[111] The cases relied upon by the defendants in their submissions to assert the point that the licensor should own the goodwill all relate to disputes between the licensors and licensees or in some instances cases involving the position of registered trade marks. Thus the cases of *Coles v Need*, *Roberts v Davis*, *Bostich TM*, *H & R Johnson Tiles Ltd & Anor v H & R Johnson (M)* and *Manus v Fullwood & Bland* can be distinguished from the facts of this case. Similarly the cases of *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* and *Lam Soon (M) Bhd v Forward Supreme Sdn Bhd* should be discounted and disregarded in this dispute as in those cases too the dispute was between the licensor and the licensee.

[112] In cases where third parties are involved, as in this case where the defendants are neither the licensors nor the licensees, the position set out in the cases of *Electro Cad*, *DHN Food Distributors Ltd and Haw Par Brothers International Ltd* should be applied. After all, as set out by Kamalanathan Ratnam J in *Haw Par Brothers International Ltd* such contentions should be 'brushed aside as a mere technicality'. Chao Hick Tin J held that while such arguments when can be relied in a dispute between a licensor and licensee, it cannot be relied upon by 'a defendant having no connection with the genuine goods'.

[113] In this case, the defendants have no connection with the goods of the plaintiffs and are thus in no position whatsoever to complain. Surely this would be the correct position of law as the defendants should not be allowed to hide their offending acts behinds such a technicality which would only frustrate justice from being done or seen to be done.

[114] The defendants in their submissions suggested that there has been no transfer of the goodwill from the plaintiffs' predecessors in title to the plaintiffs. The defendants have further suggested that there is no evidence to show that the plaintiffs took over the businesses of Sykt Salmi Hj Tamin and Sykt Zamani Hj Tamin. This proposition is difficult to accept. Firstly, there is documentary evidence in the form of the memorandum and articles of association which shows the objects of the plaintiffs which include the taking over of these businesses. Secondly, there is evidence that the plaintiffs continued with the activities previously operated by the businesses of Sykt Salmi Hj Tamin and Sykt Zamani Hj Tamin. Finally, the operations were in the full knowledge of all relevant parties. Therefore, clearly, the plaintiffs had in fact taken over the businesses previously run by Sykt Salmi Hj Tamin and Sykt Zamani Hj Tamin respectively and their other predecessors. The facts clearly and in reality point towards the plaintiffs having taken over the businesses of

Sykt Salmi Hj Tamin and Sykt Zamani Hj Tamnin and flowing with it is the goodwill associated with those businesses. A

[115] The response of the plaintiffs in dealing with the defendants challenges to their ownership in the goodwill could be summarised as follows: B

(i) The licensor/licensee arrangements suggested by the defendants to defeat the plaintiffs ownership in the goodwill deal with registered trade marks and should not affect the common law position which is the foundation of this action;

(ii) However, even if the court were to accept that the licensor/licensee arrangement in this case extends to common law rights, the authorities clearly demonstrate that there are instances where the goodwill and reputation would vest with the licensee who conducts business and uses the mark; C

(iii) This is even more the case when the dispute is not between the licensor and the licensee but with a third party (as in the present case). The courts in such instances would not allow the defendants to rely on such a technicality to defeat the action brought by the plaintiffs; and D

(iv) The evidence clearly pointed towards the plaintiffs having taken over the businesses of their predecessors in title thereby according them all goodwill associated therewith. E

[116] In conclusion of this issue, it is clear with the aid of the authorities set out above that the plaintiffs have goodwill and reputation in their business with reference to the 'TAMIN' trade mark. F

MISREPRESENTATION

[117] Misrepresentation in the passing off sense is a false representation on the part of the defendant which causes damage to the goodwill and reputation of the plaintiff through an unlawful association created between the defendant and the plaintiff. As set out by Lord Parker in *Spalding v Gamage* at p 450: G

> the basis of a passing off action being a false representation by the defendant, it must be proven in each case as a fact that the false representation has been made. It may, of course, have been made in express words, but cases of express misrepresentation of this sort are rare. The more common case is where the representation is implied in the use or imitation of a mark, trade name, or get-up with which the goods of another are associated in the minds of the public H

[118] In the case of *Reckitt & Colman Product Ltd v Borden Inc & Ors* it was held by Lord Oliver in the House of Lords judgment at p 880 of the report that misrepresentation relates to representation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods and services offered by him are goods and services of the plaintiff. I

[119] In *Pakai Industries Bhd v Chen Yew Industries Sdn Bhd* (1991) 2 CLJ 1574 Zakaria Yatim J held at p 1576 that to 'satisfy the requirement of misrepresentation the applicant must prove two points, firstly that the respondent's use of the mark is likely to deceive or cause confusion'.

[120] Given the 40 years head start that the plaintiffs would have over the defendants, it is clear that the 'TAMIN' trade mark would naturally be associated with the plaintiffs as opposed to the defendants. This is the only logical conclusion given the overwhelming and phenomenal sales and promotional activities of the plaintiffs.

[121] As stated in *Pakai Industries*, central to the requirement of misrepresentation is the issue of confusion and deception. This can be viewed in the context of whether a purchaser accustomed with the first used trade mark would confuse the later trade marks as being associated or connected with the first trade mark.

[122] In deciding whether confusion and deception is present, the marks have to be compared. The elements of the mark have to be viewed in totality looking at the circumstances of the trade. In *Tong Guan Food Products Pte Ltd v Hoe Huat Hing Foodstuff Pte Ltd (1991) 2 MLJ 361* Yong Pung How CJ in delivering the decision of the Court of Appeal in Singapore stated at p 366 of the report that:

> It is necessary for the court to take into account the nature of the purchasing public, the extent of the confusion and the way in which the confusion arises. The test for the comparison of confusingly similar marks or other distinguishing indicia is not to compare them side by side but to take into account the fact that confusion which may occur will take place when the consumer has in his mind his recollection of the appellant's mark which may well be only an idea of the whole or actual mark.

[123] From the facts of the present case, it is without doubt that the marks of the plaintiffs and that used by the defendants are confusingly and deceptively similar. In fact this is an issue which seems to have been agreed upon by the defendants which explains their necessity for their counter claim. The contention raised by the defendants as set out in their counter claim and the manner in which the evidence has been led, is that whilst they may agree that the plaintiffs or their predecessors may have been the first parties to use the 'TAMIN' trade mark, it was they (the defendants) who had first used it in relation to syrups and cordials. It is therefore they and not the plaintiffs who have goodwill and reputation in relation to the 'TAMIN' trade mark vis a vis he business of syrups and cordials.

[124] The evidence has shown and in fact on the admission of the witnesses of the defendants that the 'TAMIN' trade mark has been used by the plaintiffs prior to the use by the defendants. This is even so in the case of syrups and cordials. We have seen from the admission of DW1 that the defendants only commenced use of the 'TAMIN' trade mark in relation to their drink products in October 1990 (in answer to question 8 of his witness statement). This taken together with the survey evidence relied upon by the defendants and the testimony of DW6 clearly shows that the

plaintiffs had used the 'TAMIN' trade mark in relation to syrup bases and cordials before the use by the plaintiffs. This conclusion is clear from the facts as would be demonstrated below. A

[125] Firstly DW6 in cross examination admitted that no interviews were conducted pursuant to the survey after 26 March 2000. In p 395 of Bundle B6, pursuant to questions asked during the survey (the findings of which were admitted as D128), I was clear that 33% of those buying 'TAMIN' syrup had been using it for more than 10 years at the time the interview was conducted. Although admittedly 29% of the said respondents identified at the defendants 'TAMIN' syrup as the brand that they had been using for more than 10 years. This is a admission by the DW1. We have also seen from the evidence of PW1 during cross examination that the 'TAMIN' trade mark had been used in relation to syrups by the plaintiffs and/or their predecessors since the 80s or perhaps even earlier given the long history of the plaintiffs and predecessors in title over the 'TAMIN' trade mark. Further with reference to exh D130 (which are questionnaires done by the defendants) with particular reference to pp 528, 529, 581,593, 594, 638, 640 of Bundle B6, it is clear that some of the respondents had been using syrups and cordials bearing the 'TAMIN' trade mark in the 1980s which is well before its use by the defendants. B C D

[126] Therefore, the court is satisfied that the 'TAMIN' syrup that had been used for more than 10 years at the time the survey was conducted would have to be the plaintiffs or their predecessors 'TAMIN' syrup. Given the fact that it clearly could not have been the defendants syrup (which by admission was only introduced in late 1990), it must have been the plaintiffs or their predecessors 'TAMIN' syrup (as admitted by PW1). E

[127] Being the first in time even in Kelantan, which is not necessarily the stronghold of the plaintiffs, the plaintiffs would and should have prior rights to the 'TAMIN' trade mark. It is trite law that the first to use a mark in Malaysia would prevail. Otherwise it would result in an anomaly in the law in the sense that the first and original user of a mark is defeated by a subsequent user. F

[128] However, even if we were to accept that the defendants introduced their 'TAMIN' syrup in 1990 and even if we were to accept that at the time of its introduction, the plaintiffs had not used TAMIN' in relation to syrups, the defendants do not necessarily have rights to the 'TAMIN' trade mark in Malaysia when used in relation to syrups, drinks and cordials. G

[129] It is important to note that the concept of misrepresentation is not dependant on whether the goods traded in are the same or that there is a common field of activity. The issue is whether confusion and deception would arise out of the uge of the mark by the defendants. Needless to say, when the goods to which the respective marks are applied to are the same or if there is a common field of activity, H I

A the incidence of confusion and deception is greater. However, this is not pre-requisite in a passing off suit. All that needs to be proven is whether the subsequent use of the mark would result in confusion and deception.

[130] In *Harrods v Harrodian School (196) RFC 697*, Millet LH in the Court of
B Appeal stated at p 714 that:

> there is not requirement that the defendant should be a carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiffs business.

C **[131]** Millett LJ further held that:

> What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among common customers and parties. The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding
D whether there is a likelihood of confusion, it is an important and highly relevant consideration '… whether there is any kind of association, or could in the minds of the public any kind of association, between the fields of activities of the plaintiff and the field of activity of the defendants; Annabel's (Berkeley Square) Ltd v G Schock per Russell LJ.
>
> In the Lego case Falconer J likewise held that the proximity of the defendants' activity to
E that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

[132] In *Lego system A/S v Lego M Lemelstrich Ltd* (1983) FSR 155 Falconer J in the court granted a permanent injunction to the makers of well known children's building bricks against admittedly bona fide use of the name by the defendants for
F garden irrigation equipment.

[133] In *Annabel's v Schock* (1972) RFC 838, the Court of Appeal found for the plaintiffs who owned a night club against the use of the plaintiffs' name by the defendants in relation to an escort agency.

G

[134] In line with these authorities and the accepted position of law, the defendants contentions, even if accepted does not accord them with a defence in this case. A further example of a case where the plaintiffs in a different field of activity was successful can be seen in the case of *Eastman Photographic Materials Co v John*
H *Griffiths* (1898) 15 RPC 105. In that case the plaintiff camera manufacturer restrained the use by the defendants of 'Kodak' for bicycles.

[135] The present case is even more clear. This is even on the assumption that we accept that the defendants were the first in time to use the 'TAMIN' trade mark in relation to syrups and cordials. Firstly, food and drink items of goods of the same
I description and offered through the same channels. We have seen in the course of the trial that both parties' goods are found or potentially found in the same stores.

We have further seen from the evidence that the plaintiffs have expended their range of products which was initially 'kicap' to a wide range of food and drink items. This is the culture of the plaintiffs and their predecessors in title since 1951. The evidence has also shown that the trade and purchasing public throughout the country are aware of this culture of the plaintiffs, and know very well of the expansion of their business and their wide range of products offered for sale all carrying the 'TAMIN' trade mark. This is clearly illustrated in the evidence of PW4. We have seen that this culture of expansion was well in place before the defendants' 'TAMIN' allegedly came into the picture. This being the case, the 'TAMIN' trade mark whether used in relation to items of food or drink are distinctive of the plaintiffs and the defendants subsequent acts of using the 'TAMIN' trade mark in relation to syrups, cordials and drinks would inevitably lead to confusion and deception.

[136] In conclusion, even if we are to accept that the 'TAMIN' trade mark in relation to syrups and cordials were first used by the defendants, this does not necessarily give them rights to the 'TAMIN' trade mark albeit in those fields over and above the plaintiffs. The position of law is that given the plaintiffs' consistent use and expansion of the use of the 'TAMIN' trade mark in relation to various items of food and drink, it is they and not the defendants who should be able to claim to have rights to the mark in Malaysia, whether in relation to items of food or drink. This being the case, and given the fact that the plaintiffs and their predecessors are the prior users of the 'TAMIN' trade mark in Malaysia it is the defendant and not the plaintiffs who have indulged in acts which would lead to confusion and deception.

[137] The defendants further contention was that they had come up with the 'TAMIN' name independently and that they were bona fide in their approach. This contention is difficult to accept. The evidence clearly shows that the plaintiffs and their predecessors had been using the 'TAMIN' trade mark for a substantial period of time. This being the case, the products of the plaintiffs have been readily available in the market in Malaysia. For the defendants to say that they were unaware of the plaintiffs and their rights is therefore unacceptable and without merit.

[138] However, even if we are to accept that the defendants choice of 'TAMIN' was made bona fide, this cannot be a legitimate defence. As referred in The Law of Passing-off-Christopher Wadlow (Third Edition) (Tab 25 IAP 3) at p 313:

> The defendant's state of mind is wholly irrelevant to the existence of a cause of action in passing of.

[139] The defendants in their submissions have then sought to argue that they are honest concurrent users of the 'TAMIN' trade mark in Malaysia and there would be no misrepresentation in this regard they have sought to rely on various authorities and argued that they had been using the 'TAMIN' trade mark for a substantial period of time when this suit was filed. This contention would not find support from the undisputed facts of the case.

[140] Firstly, the plaintiffs and their predecessors in title had been using the 'TAMIN' trade mark since 1951. There had been extension of the goods to which the 'TAMIN' trade mark was used in relation to and the 'TAMIN' trade mark was used in relation to syrups since the 1980s. This well before the use of the 'TAMIN' trade mark by the defendants. We have also seen from the evidence of the defendants that they concentrated their efforts for the sale of their products in Kelantan despite the fact that their business operated from Kuala Lumpur. We have further seen that the plaintiffs while selling their products in Kelantan and Terengganu for some time were not that aggressive in those areas. It would thus seem that the defendants deliberately chose the location of Kelantan to escape the attention and detection of the plaintiffs. Surely in light of the above, they cannot be allowed to claim honest concurrent use when their intentions and actions have been less that honest.

[141] In conclusion, it has to be said that the evidence clearly shows misrepresentation on the part of the defendants. The summary of the facts and law which point towards that conclusion are as follows:

(i) The plaintiffs and/or the predecessors were the first users of the 'TAMIN' trade mark in relation to a whole range of products. This would also include syrups and drink items. This can be gleaned from the undisputed facts;

(ii) The defendants only commenced use of the 'TAMIN' trade mark well after the use by the plaintiffs; and

(iii) The evidence showed that the trade and public confused the defendants' 'TAMIN' as and for the plaintiffs' 'TAMIN'.

DAMAGES

[142] The action for passing off as propounded in the various cases as well as set out in the classical trinity of *Reckitt & Colman Products Ltd v Borden Inc* protects the plaintiff's right of property in his business or goodwill. It is therefore essential that the defendant's misrepresentation should be such as to be likely to cause substantial damage to that property. As stated by Lord Fraser in the *Erven Warnink* case, the claimant must show:

> That he has suffered, or is really likely to suffer substantial damage to his property and goodwill.

[143] It is also settled law that actual damage need not be proven. A probability of damage is sufficient. As per Buckley LJ in *Bulmer (HP) Ltd v Bolinger SA* (1978) RPC 79:

> It is settled law that the plaintiff in a passing off action does not have to prove that he has actually suffered damage by loss of business or in any other way. A probability of damage is enough….

[144] There are various heads of damage but the generally recognised heads of damage could be labeled in two way which are destruction and diversion. In the first case (destruction), the goodwill is destroyed, damaged or depreciated. In the second case (diversion), the goodwill as such may not initially be damaged to any measurable extent, but the plaintiff is just as certainly deprived of its benefit the attractive force which the goodwill may draw in custom as powerfully as before, but draw it to the defendant instead of the plaintiffs.

[145] As put by Laddie J in *Irvine v Talksport* (2002) 60 FSR 943 at p 955.

> The purpose of a passing off action is to vindicate the claimant's exclusive right to goodwill and to protect it against damage. When a defendant sells his inferior goods in substitution for the claimant's there is no difficulty in a court finding that there is passing off. The substitution damages the goodwill and therefore the value of it to the claimant. The passing off action is brought to protect the claimant's property. But goodwill will be protected even if there is minimal damage in the above sense. For example, it has long been recognised that a defendant cannot avoid a finding of passing off by showing that his goods or services are as good or better quality than the claimant's. In such a case, although the defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the claimant because instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it.

[146] In the present case, the plaintiffs have shown both losses. Firstly, there is the possibility of misappropriation of the goodwill and commercial advantage enjoyed by the plaintiffs in relation to products bearing the 'TAMIN' trade mark in the sense that exclusivity to 'TAMIN' is lost. Secondly, if the products of the defendants do not meet up to the quality associated with the plaintiffs' products, the trade and public would associate such lack of quality to the plaintiffs.

[147] In looking at the heads of damage, the evidence clearly shows that the acts of the defendants would lead to damage to the plaintiffs. The defendants by employing the 'TAMIN' trade mark in relation to their goods are clearly taking an unfair advantage out of the goodwill and reputation of the plaintiffs.

[148] Given the possibility of association as set out above and the fact that the defendants are in a common field of activity with the plaintiffs, there would be a clear danger of diversion and damage to the plaintiffs. As set out in the decision of Gunn Chit Tuan CJ (Malaya) in the Supreme Court decision of *Seet Chuan Seng v Tee Yih Jia Foods Manufacturing Pte Ltd* (1994) 2 MLJ 770 at p 782:

> In an action for passing off, damage is also an essential element of the tort and it is necessary for the plaintiff to establish that he has suffered damage. However, if the goods in question, as in this case, are in direct competition with one another, the court will readily infer the likelihood of damage to the plaintiff's goodwill through loss of sales and loss of the exclusive use of his name.

[149] However, even if we were to assume that 'TAMIN' in relation to syrups was first introduced by the defendants and not the plaintiffs (which on the evidence cannot be the case) this does not necessarily mean that the plaintiffs' claim against the defendants would fail. Food and drinks are articles of the same description and are sold through the same trade channels. This in addition to the fact that the plaintiffs have a culture of expansion of their range of products would clearly result in the public associating 'TAMIN' to the plaintiffs. Thus when a customer sees 'TAMIN' when used in relation to articles of food and drink they would assume that it is the products of the plaintiffs. The defendants by using the 'TAMIN' trade mark in relation to their products, whatever their intention would clearly benefit out of such use. This benefit to the defendants coupled with the loss of business suffered by the plaintiff is clear damage to the business goodwill and reputation of the plaintiffs.

[150] Having said that the facts of this case point towards actual incidences of damage to the goodwill and reputation of the plaintiffs. PW3 related an incidence where a manager of a store in Seremban returned the defendants' products to him (being a representative of the plaintiffs) as he (the said manager) was dissatisfied with the quality of the products. This is a clear example where the quality of the defendants products were associated with the plaintiffs when the plaintiffs had no such association with the defendants. This is an instance of actual damage to the business and goodwill of the plaintiffs. The other example would be the testimony of PW4. PW4 testified that the purchased the defendants products in the belief that it was the products of the plaintiffs that he was accustomed. This is damage in the form of diversion to sales and business from the plaintiffs to the defendants.

[151] By reason of the above, it is clear that the acts of the defendants would undoubtedly result in damage to the goodwill and reputation of the plaintiffs. In summary, the plaintiffs would lose exclusivity over their well established and developed trade mark. If the defendant's products do not meet up to the standards associated with the plaintiffs products, such lack of quality would be undoubtedly attributed to them resulting in loss to the goodwill and reputation. The third form of loss would be the defendants' ability to unlawfully profit from their acts without compensating the rightful owners of the 'TAMIN' trade mark being the plaintiffs.

DEFENCE OF ACQUIESCENCE AND LACHES

[152] The defendants in their submission contended the defence of acquiescence and laches.

[153] The defendants contended that they had been manufacturing syrups and cordials since the 1990s. However, as the evidence has shown and as admitted by the defendants themselves, the sales of their products carrying the 'TAMIN' trade mark was limited to Kelantan only. We have further seen that at that time the plaintiffs were not that aggressive in Kelantan, a fact that must have been known to the defendants.

[154] Although the defendants have attempted to suggest that when they introduced their 'TAMIN' products no other party had been using the 'TAMIN' trade mark in relation to syrups and cordials, the evidence of the defendants' witnesses themselves point towards the fact that this is not an accurate statement and it is the plaintiffs and/or the predecessors who were the first users of the 'TAMIN' trade mark even in relation to syrups and cordials.

[155] The defendants then suggested that the plaintiffs knew about them since 1996 when a letter of demand was sent out to an associated company of the plaintiffs' Maju Tamin (M) Sdn Bhd. However, a very important fact has been left out by the defendants in their submissions. In fact, the plaintiffs did respond to the defendants demand and suggested that it is the plaintiffs who were the true proprietors of the 'TAMIN' trade mark even when used in elation to articles of drink. Sadly the defendants did not reply to the said letter and cited cost constraints for not taking the matter further. The plaintiffs on the other hand when they did not receive any response from the defendants could not be faulted in assuming that the defendants having realised the superior rights of the plaintiffs did not wish to pursue the matter further. The plaintiffs could not also be faulted in assuming the defendants had ceased in the activities in 1996 after having received no response from the defendants to their demands. The converse however has to be said of the defendants. They knew fully well that the plaintiffs would be asserting rights to the said trade marks when they received a response from the plaintiffs. They must have known that the plaintiffs would be jealously protecting their rights in relation to the 'TAMIN' trade mark. Yet, despite the defendants' assertion that the 'TAMIN' trade mark was an important trade mark to them, the defendants did not take the matter up further. Therefore, it would be the defendants and not the plaintiffs who would be guilty of laches if that is found to be existing on the facts.

[156] The evidence has further shown that subsequent to the plaintiffs' response that they were the legitimate proprietors of the mark, it was the plaintiffs who took further action against the defendants in 1998 when they discovered the continued presence of the defendants goods in the market in 1998. This is seen from the filing of this suit and the enforcement actions taken against the defendants. The evidence also showed that the actions against the defendants were somewhat delayed due to an inaccurate address on the label of the defendants' products.

[157] The defendants then went on to argue that at the time they commenced use of the mark in 1990, the plaintiffs had yet to establish the required reputation and goodwill. This argument is against the evidence adduced during trial. It has to be observed that even at that date, the plaintiffs and/or their predecessors had in fact established significant goodwill and reputation in their businesses with reference to the 'TAMIN' trade mark. This is patently obvious from the evidence adduced. The 'TAMIN' products of the plaintiffs and their predecessors in title were in the market long before even 1990 when the defendants allegedly introduced 'TAMIN' in relation to their range of products. The plaintiffs and their predecessors had in fact established significant goodwill and reputation in their business by 1990. Thus at the

time of commencement of this action or at the time of alleged commencement of the usage of 'TAMIN' by the defendants, the plaintiffs had already established significant goodwill and reputation in their business with regard to the 'TAMIN' trade mark.

[158] The defendants then suggested that although they may have been guilty of passing off in 1990, they were not guilty of passing off now as they had established themselves as market leaders from the year 2000. In this regard they seem to have relied on the market survey introduced by DW6. Before accepting this assertion, the facts of the case have to be considered. In this case, the defendants' business which operated from Kuala Lumpur nevertheless deliberately chose Kelantan as their market for their products carrying the 'TAMIN' trade mark. They could have easily operated in the west coast as well but this was not done. In fact the defendants have chosen to rely on a survey which is limited to Kelantan to say that the 'TAMIN' trade mark is distinctive of them. We have seen that the manner that the survey was conducted was hardly balanced on the facts and was aimed at arriving at a conclusion which was favourable to the defendants. Even still, the survey for reasons set out above established that the plaintiffs were first in time even in the Kelantan market.

[159] Thus it can hardly be said that the facts point towards passing off not being present at the time of commencement of the suit. The survey is not representative of the state of affairs of the entire country and even if admitted (and this too is questionable) relates only to Kelantan. The survey was done in the year 2000 and thus is not indicative of the state of affairs in 1990 (when the defendants allegedly started using 'TAMIN') or 1998 (when the suit was filed). The evidence as led in the course of the trial clearly shows the continuing incidence of confusion and deception through out the whole country.

[160] The deliberate and inexplicable conduct of the defendants in choosing the Kelanan market offers sufficient explanation as to why action was not taken against them earlier.

THE DEFENDANTS' COUNTER CLAIM — PASSING OFF

[161] The defendants contention as set out in their counter claim was that since they were the first parties to have used the 'TAMIN' trade mark in relation to syrups, they would have priority of rights and this priority of rights is even over and above the rights of the plaintiffs.

[162] For the defendants to succeed in passing off, they would be required to satisfy the same conditions that the plaintiffs were required to satisfy as set out above (ie goodwill which has been damaged by the misrepresentation of the plaintiff).

[163] However, as seen in the evidence considered thus far, it is clear that the plaintiffs and not the defendants who were the first users of the 'TAMIN' trade mark. They were first users in relation to kicap, soya sauce and a variety of food and drink

items and they were the first users of the 'TAMIN' trade mark vis a vis syrups, cordials and drink related products. This is the only logical conclusion that could be drawn and inferred from the testimony of all the relevant witnesses.

[164] The evidence has further shown that the plaintiffs had a good reason to use the 'TAMIN' trade mark as 'TAMIN' was the name of the founder of the plaintiffs predecessors in title. The defendants on the other hand had the flimsy reason of choosing 'TAMIN' as being a harvesting knife thus giving luck to their business. 'TAMIN' is not a common word. It is a name of a person, in this case is the founder of the plaintiffs predecessors in title — one Hj Mohd Tamin bin Wahi.

[165] In *Midgley v Morris & Cowdery* (1904) 21 RFC 314, the plaintiffs claimed that the slogan 'Fair Wear or a Free Pair' for shoes was distinctive of them but their case collapsed when it was proved that the defendants had used it first. This being the case and given the fact that it was the plaintiffs in this case who had use the 'TAMIN' trade mark first, the defendants counter claim is doomed to fail.

[166] The defendants principle issue is that their 'TAMIN' trade mark has been found to be distinctive of them when used in relation to syrups and cordials. In support of this contention, the defendants relied on various consumer and trade witnesses. The defendants further commissioned a survey to ascertain which 'TAMIN' trade mark was distinctive. It is interesting to note that all such evidence adduced by the defendants related to purchasers and traders in Kelantan. The defendants have conveniently forgotten the rest of Malaysia in their quest to show that their mark is distinctive. We have seen from the evidence of the witnesses of the defendants that the defendants concentrated all their early commercial efforts vis a vis 'TAMIN' in the state of Kelantan and we have seen that during that time, the plaintiffs were not that aggressive in Kelantan. Such selective usage and introduction of evidence can hardly be said to be representative of the cross section of the public and should not be taken as the basis for deciding if the defendants trade mark is distinctive of them or otherwise. After all, the injunction sought by the defendants in their counter claim is to extend throughout the country. This can be contrasted by the evidence led by the plaintiffs which showed that the 'TAMIN' trade mark was distinctive of them throughout the country and not just limited to certain geographical areas.

[167] Further, as can be seen from the evidence of DW6, the target respondents to the survey were the very customers that the defendants often have and were not targeted to reach out to a cross section of the public. This being the case, the evidence tendered by the defendants in support of their contention that the 'TAMIN' trade mark is distinctive of them should be given very little or no weight.

[168] Even if the defendant would argue that at least insofar as Kelantan is concerned, they are the common law proprietors of the mark, this position is unsustainable in law for reasons set out below

[169] Although admittedly, the plaintiffs were not aggressive in Kelantan at the time of the alleged first use of the defendants of the 'TAMIN' trade mark, this in itself is insufficient to defeat the plaintiffs case in passing off. On the same token, this would also mean that the defendants do not have a cause of action in passing off against the plaintiffs.

[170] In the case of *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* (1987) RFC 189 (Tab 29 IAP 3), the courts were reluctant to confine the claimant's goodwill to a particular locality. Similarly in this case, whilst the plaintiffs initially at least were not active or aggressive in Kelantan, their goodwill by virtue of their trading elsewhere in Malaysia should extend and include Kelantan. With the advent of modern transportation, it is inevitable that the products of the parties would trickle into the other parts of the country.

[171] The defendants may argue that the decision in the *Chelsea Man* case actually supports their position in the sense that their local use of 'TAMIN' in Kelantan should give them rights throughout Malaysia. This position would only be sustainable if the defendants were the first users of 'TAMIN' in Malaysia. In such an instance, the defendants can legitimately claim that their reputation and goodwill would not be limited to the regional location of Kelantan and transcends through the whole of Malaysia. The facts of this case are clearly different. In this case, the plaintiffs either through themselves or their predecessors had used the 'TAMIN' trade mark since 1951. Since the first use of the TAMIN' trade mark in relation to 'kicap', there has been a significant extension and expansion as to the nature of goods to which the 'TAMIN' trade mark has been used in relation to. Initially at least it was in relation to food items such as vinegar, chili sauce, tomato sauce, 'tauchu', 'bi-hun' and a variety of other products. This is clear and undisputed from the facts. Sometime in the 1980s, the evidence of PW1 showed that the 'TAMIN' trade mark was used in relation to drink items. This is corroborated by the evidence of DW6 which showed the existence of the plaintiffs 'TAMIN' syrups and cordials in the 1980s. Thus clearly, the plaintiffs were the first in time to use 'TAMIN' in relation to food and drink items in Malaysia. This being the case, the *Chelsea Man* decision would support the plaintiffs case, notwithstanding the fact that they may not have used the 'TAMIN' trade mark extensively in Kelantan in the early days. Since their rights to the 'TAMIN' trade mark clearly stand in priority over the rights of the defendants, it is their case in passing off that should be entertained and not the defendants'. This would naturally mean that the defendants counter claim against the plaintiffs for passing off should fail.

[172] As the plaintiffs were the first in time to use 'TAMIN', it is they who should prevail over such use. To hold otherwise would give rise to an absurd situation. It would mean that just because a party who has been using his trade mark in a bona fide way has not aggressively used his trade mark in a given locality (whilst aggressive in other parts of the country), he would be deprived of such use by a subsequent user who was more aggressive (only in the said locality). Surely the court cannot arrive at

such a finding simply because it is trite law that the first in time should not have his rights altered or remove, by the subsequent unauthorised action.

[173] For reasons set out above, there is no sustainable reason in fact or in law to uphold the defendants counter claim in passing off.

SLANDER TO TITLE AND GOODS

[174] The basis of the defendants action for slander to title and goods, against the plaintiffs is the complaint made by the plaintiffs to the Enforcement Division of the Ministry of Domestic Trade and Consumer Affairs. This is found in para 42 of the defendants defence and counter claim. The complaint by the plaintiffs stated that the defendants were indulging in activities which were contrary to the Trade Descriptions Act 1972.

[175] The courts are of the view that the plaintiffs were clearly within their legal limits to make the complaint and enforce their rights under the law. The reasons for such a conclusion are set out below and finds support in the various authorities.

[176] The essential requirements to sustain a course of action in slander to title and slander to goods are set out by Glidewell LJ in *Kaye v Robertson* (1991) FSR 62 at p 67, as follows:

> The essentials of this tort are that the defendant has published about the plaintiff words which are false, that are published maliciously and that special damage has followed as the direct and natural result of their publication.

[177] In the interest of clarity, the court shall deal with each of these requirements in turn.

FALSITY OF THE PLAINTIFFS' STATEMENTS

[178] In this regard, the defendants in their counter claim relied on the complaint made by the plaintiffs to the enforcement division that the usage of the defendants of TAMIN' were false trade description under the Trade Descriptions Act 1972.

[179] The question that should be asked here is whether the statement of the plaintiffs to the enforcement division were made falsely. In this regard, given the claim by the plaintiffs in passing off, the court is of the view that the statements made to the enforcement division were true. The claim of the plaintiffs in passing off are clearly made out as seen in the judgments set out above. As this is the case, and since the defendants had employed to use of the 'TAMIN' trade mark in relation to their goods well after the use of the 'TAMIN' trade mark by the plaintiffs, it is clear that the defendants had been indulging in acts which could only be defined as passing off their products as and for the products of the plaintiffs.

[180] This being the case, it is clear that the statements made by the plaintiffs to the enforcement division were true and thus the claim by the defendants of slander must necessarily fail. There is no issue of disparagement clearly because the plaintiffs statements were true. Denigration does not arise and the plaintiffs are well within their rights to complain to protect and preserve their rights. As a matter of fact, the complaint of the plaintiff was independently evaluated by the enforcement division and even they held the position that the plaintiff's complaint was well founded and legitimately made.

MALICE

[181] The defendants would also fail on their counter claim on this issue as they have not shown any malice on the part of the plaintiffs in making the complaint. Whilst the defendants have alleged malice, they have not particularised the incidence of malice. Neither have they led any evidence to show that the plaintiffs in making the complaint made the complaint with malice.

[182] On the other hand, on the evidence of PW1, it is clear that the complaint was made on the basis of protecting what the plaintiffs have always believed to be a legitimate right that they possess. This is supported by the consistent position that the plaintiffs have taken since the making of the complaint which includes the filing of this suit to protect their rights.

[183] In *Greers Ltd v Pearman and Corder Ltd* (1922) 39 RFC 406 Scrutton LJ said at page 417 that -

> Honest belief in an unfounded claim is not malice….

[184] In the present case, the plaintiffs through their conduct have shown an honest belief in their claim. What is even more obvious is that the plaintiffs claim in passing off is clearly not unfounded.

[185] In *Halsey v Brotherhood* (1881) 19 Ch D 389, Lord Coleridge CJ at p 389 held that:

> It appears to me that a statement made under such circumstances does not give a ground merely because it is untrue and injurious to the plaintiff; there must be also the element of mala fides and a distinct intention to injure the plaintiff apart from the honest defence of the defendant's own property.

[186] In *British Railway Traffic v CRC Co* (1922) 2 KB 260, McCardie J held at p 269 that:

the mere absence of just cause or excuse is not itself malice. Malice in its proper and accurate sense is a question of motive, intention or state of mind.

[187] In the present case, it is clear that the plaintiffs' complaint was legitimately made. They had used the 'TAMIN' trade mark for more than 40 years when the defendants allegedly started using the same. Clearly they were aggrieved by a subsequent user of a mark that they had so painstakingly developed. They thus filed the complaint to the enforcement division and followed it up with this suit. The plaintiffs have strongly held firm to their ascertain that they were the rightful owners of the 'TAMIN' trade mark in Malaysia. And as the evidence would show, this contention and believe clearly has merits and the plaintiffs were entitled to protect their rights. The procedure to file complaints at the enforcement division of the Ministry of Domestic Trade and Consumer Affairs is one such way of enforcing their rights. The other is to file this suit and the plaintiffs have done both. What is abundantly visible is the consistency in the plaintiffs position in maintaining their stand that they are the true and proper owners of the 'TAMIN' trade mark and thus are entitled to make this complaint.

DAMAGE

[188] The final condition is that damage must result from the plaintiffs' publication. In this regard, the defendants seem to be relying on the damage caused as a result of the raid conducted on their premises.

[189] The court is of the view that this damage is not recoverable. Firstly, the complaint was legitimately made by the plaintiffs. Secondly, there was no malice in the complaint of the plaintiffs. Finally and more importantly under this head, the actions to enforce and conduct the raid were the actions of the enforcement division after having been fully satisfied with the complaint of the plaintiffs. This being the case, damages suffered by the defendants can hardly arise out of the actions of the plaintiffs.

[190] Based on the above, it is clear that the defendants cause of action in slander to title and goods must necessarily be doomed to fail.

[191] In any event, it must be noted that the defendants have not submitted on the issue of slander to title and goods in their written submissions. It is only logical for the court to infer that the defendants seem to be abandoning their claim under this head.

CONCLUSION

[192] In conclusion, the court, on the balance of probabilities, makes the following findings:

(i) The plaintiffs and/or their predecessors in title were the first in time to use the 'TAMIN' trade mark in Malaysia. The use of 'TAMIN' by the plaintiffs and/or the predecessors in title commenced in 1951 and was the name of the founder of the plaintiffs' predecessors in title which is Hj Tamin bin Wahi;

(ii) The plaintiffs and their predecessors expanded usage of the 'TAMIN' trade mark to cover a wide range of food and drink items. The evidence also showed a consistent increase in the nature of products offered for sale by the plaintiffs. The 'TAMIN' trade mark was used in relation to these products before the date of introduction of the same by the defendants;

(iii) The usage of the 'TAMIN' trade mark in relation to syrups and cordials by the plaintiffs and their predecessors in title was in the 1980s;

(iv) The 'TAMIN' trade mark is currently used by the plaintiffs within the Tamin group of companies;

(v) The evidence of usage of the 'TAMIN' trade mark by the plaintiffs had resulted in goodwill and reputation to their business which is a property right protected under the law of passing off';

(vi) The defendants commenced use of the 'TAMIN' trade mark at the very earliest in the 1990s in relation to syrups and cordial. This use is well after the introduction of the 'TAMIN' trade mark by the plaintiffs. The early use by the defendants of the 'TAMIN' trade mark was confined to the geographical area of Kelantan; and

(vii) The use of the defendants of the 'TAMIN' trade mark has resulted in confusion and deception resulting in damage to the goodwill and reputation of the plaintiffs.

[193] By virtue of the above findings, it is clear that the plaintiffs' case in passing off has been established on the balance of probabilities. They, by being the first user of the 'TAMIN' trade mark in Malaysia are clearly entitled to the exclusive use of the 'TAMIN' trade mark when used in relation to the goods of interest to them which are articles of foods and drink. The defendants who are the subsequent users of 'TAMIN' are thus not entitled to the usage of the 'TAMIN' trade mark in relation to their syrups and cordials.

[194] By reason of the above, the facts point clearly towards a decision in favour of the plaintiffs being the first users of the 'TAMIN' trade mark. This would further necessarily mean that the counter claim of the defendants both in passing off and slander to title and goods would also collapse. This is the only logical conclusion having looked at the facts. Surely a subsequent user of the mark should not be allowed to frustrate the use of an earlier user.

[195] By virtue of the above, the court allows the plaintiffs' prayer as set out in the statement of claim with cost (with damages to be assessed by the Registrar) and at the same time dismiss the defendants' counter claim with cost.

Defendants' counter claim dismissed with costs.

Reported by Peter Ling